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36998

MRZ 8980
PATENT

11/10/04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of David C. Carrithers et al. Art Unit 3622
Serial No. 09/399,597
Filed September 20, 1999
Confirmation No. 2447
For DEBIT CARD SYSTEM AND METHOD FOR
IMPLEMENTING INCENTIVE AWARD PROGRAM

April 5, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

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GROUP 3600

SIR:

PETITION TO CONTINUE SUSPENDED ACTION UNDER 37 C.F.R. 1.103(a)

In accordance with 37 C.F.R. 1.103(a) and MPEP 709,
Applicants request an additional six (6) month suspension of
further action by the Patent Office to October 3, 2004.

The present application is a continuation of U.S. Patent
Nos. 5,689,100 and 5,956,695. These patents are presently
involved in litigation. Applicants filed a "Petition to Suspend
Action Under 37 C.F.R. 1.103(a)" on October 3, 2003. The Office
communication mailed October 29, 2003 granted Applicants'
Petition. At the time of the granting of the petition, a Markman
hearing in this litigation had been scheduled in October, 2003.

The following selected papers have been filed in the
litigation since the Petition was filed on October 3, 2003:

1. Defendant Wildcard's First Amended Answer to Plaintiffs'
Second Amended Complaint filed January, 13, 2004;
2. Defendant Carlson's First Amended Answer to Second
Amended Complaint filed January 20, 2004;
3. Plaintiffs' First Amended Reply to Defendant Wildcard's
First Amended Counterclaim filed January 26, 2004;

4. Amended Case Management Order filed January 30, 2004;
5. Plaintiff's Reply to the Carlson Defendants' First Amended Counterclaim filed February 2, 2004; and
6. Memorandum and Order issued on March 3, 2004.

Thus, the Markman hearing was held in October, 2004 and Judge Perry issued the above-noted Memorandum and Order. Filed simultaneously herewith is a Fifth Supplemental Information Disclosure Statement (IDS) submitting copies of the above noted six pleadings. Document D137 of the IDS is an updated Docket Report showing the pleadings filed through April 2, 2004. Upon a request from the Commissioner, Applicants will provide copies of any other documents relating to the litigation, subject to any protective orders.

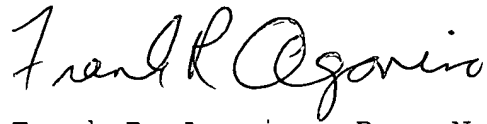
Applicants believe that the trial set for October 25, 2004 (see paragraph 4 of the Amended Case Management Order, noted above) will confirm the patentability of the remaining, asserted claims of the above noted patents. Although the pending claims of the above captioned application are different than the patented claims being litigated, they are based on the same specification. The resolution of the litigation will likely reduce the issues to be considered by the Examiner with regard to the pending claims (e.g., such as priority date issues asserted by the defendants). Therefore, Applicants request an additional six (6) month suspension to October 3, 2004 at which time the trial set for October 25, 2004 will be imminent and the status of this application and the litigation can be re-evaluated.

In accordance with 37 CFR 1.704(c)(1), Applicants acknowledge and agree to the fact that any suspension will cause a reduction in any applicable patent term adjustment under 37 CFR 1.703.

MRZ 8980
PATENT

* A check is enclosed to cover the \$130.00 fee specified in 37 CFR §1.17(h) for submission of this Petition.

Respectfully submitted,

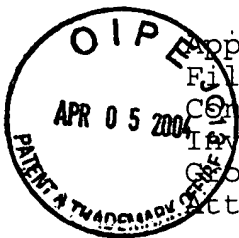


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FEE TRANSMITTAL



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GROUP 3600

Application Number 09/399,597
Filing Date September 20, 1999
Confirmation No. 2447
Inventor(s) David C. Carrithers et al.
Group Art Unit 3622
Attorney Docket Number MRZ 8980

METHOD OF PAYMENT

1. ☐ The Commissioner is hereby authorized to charge the indicated fees to Deposit Account No. 19-1345.

☐ The Commissioner is hereby authorized to charge any additional fees required under 37 CFR 1.16 and 1.17 to Deposit Account No. 19-1345.

☐ Applicant claims small entity status.
2. ☒ Check Enclosed. The Commissioner is hereby authorized to charge any under payment or credit any over payment to Deposit Account No. 19-1345.

FEE CALCULATION

1. ☐ BASIC FILING FEE Subtotal (1) \$ _____
(Type: _____)
2. ☐ EXTRA CLAIM FEES Subtotal (2) \$ _____

Total Claims _____
Independent Claims _____
Multiple Dependent Claims _____
3. ☒ ADDITIONAL FEES Subtotal (3) \$ 310.00

☐ Surcharge - late filing fee or oath
☐ Surcharge - late provisional filing fee or cover sheet
☐ Extension for reply within _____ month
☐ Notice of Appeal
☐ Filing a Brief in Support of an appeal
☐ Request for ex parte Reexamination
☒ Petitions to the Commissioner
☒ Submission of Information Disclosure Statement
☐ Recording each patent assignment per property
☐ Request for Continued Examination
☐ Other: _____

TOTAL AMOUNT OF PAYMENT \$ 310.00

Frank R. Agovino
Frank R. Agovino, Reg. No. 27,416

April 5, 2004
Date

FRAcwa

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of David C. Carrithers et al. Art Unit 3622
Serial No. 09/399,597
Filed September 20, 1999
Confirmation No. 2447
For DEBIT CARD SYSTEM AND METHOD FOR
IMPLEMENTING INCENTIVE AWARD PROGRAM

April 5, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

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APR 09 2004
GROUP 3600

SIR:

FIFTH SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

In accordance with 37 C.F.R. 1.97 and 1.98 and MPEP 609, and in compliance with the duty of disclosure set forth in 37 C.F.R.

* 1.56, applicants submit copies of the references listed on the attached PTO/SB/08A for consideration by the Patent and Trademark Office in the above-entitled application and to be made of record therein.

References D131-D136 relate to litigation involving U.S. Patent Nos. 5,689,100 and 5,956,695, from which the above captioned application claims priority.

Defendants have produced about 150,000 documents. Additional documents will be provided as Applicants (plaintiffs) identify relevant and material non-cumulative documents from the production and as defendants produce additional documents.

Document D137 is an updated Docket Report showing the pleadings filed through April 2, 2004. Upon a request from the Commissioner, Applicants will provide any other documents relating to the litigation subject to any protective order.

MRZ 8980
PATENT

* A check is enclosed is payment of the \$180.00 fee specified in 37 CFR §1.17(p) for submission of this Information Disclosure Statement.

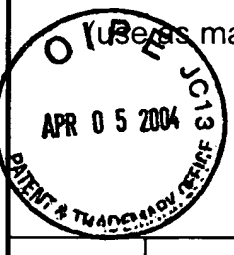
Respectfully submitted,



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PTO/SB/08A				Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary) 				Application Number	09/399,597
				Filing Date	September 20, 1999
				Confirmation Number	2447
				First Named Inventor	David C. Carrithers
				Group Art Unit	3622
				Examiner Name	Arthur D. Duran
Sheet	1	of	2	Attorney Docket No.	MRZ 8980

OTHER ART - NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.) date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ⁶
	D131	Defendant Wildcard's First Amended Answer to Plaintiffs' Second Amended Complaint, Maritz Inc. and American Express Incentive Services, L.L.C. v. Carlson Companies, Inc. and Carlson Marketing Group, Inc., Cause No. 4:02CV00161CDP, U.S. District Court for the Eastern District of Missouri, January 13, 2004, pp. 1-15 (Regarding U.S. Patent Nos. 5,689,100 and 5,956,695)	
	D132	Defendant Carlson's First Amended Answer to Second Amended Company, Maritz Inc. and American Express Incentive Services, L.L.C. v. Carlson Companies, Inc. and Carlson Marketing Group, Inc., Cause No. 4:02CV00161CDP, U.S. District Court for the Eastern District of Missouri, January 20, 2004, pp. 1-11 (Regarding U.S. Patent Nos. 5,689,100 and 5,956,695)	
	D133	Plaintiffs' First Amended Reply to Defendant Wildcard's First Amended Counterclaim, Maritz Inc. and American Express Incentive Services, L.L.C. v. Carlson Companies, Inc. and Carlson Marketing Group, Inc., Cause No. 4:02CV00161CDP, U.S. District Court for the Eastern District of Missouri, January 26, 2004, pp. 1-5 (Regarding U.S. Patent Nos. 5,689,100 and 5,956,695)	
	D134	Amended Case Management Order, Maritz Inc. and American Express Incentive Services, L.L.C. v. Carlson Companies, Inc. and Carlson Marketing Group, Inc., Cause No. 4:02CV00161CDP, U.S. District Court for the Eastern District of Missouri, January 30, 2004, pp. 1-4 (Regarding U.S. Patent Nos. 5,689,100 and 5,956,695)	
	D135	Reply to the Carlson Defendants' First Amended Counterclaim, Maritz Inc. and American Express Incentive Services, L.L.C. v. Carlson Companies, Inc. and Carlson Marketing Group, Inc., Cause No. 4:02CV00161CDP, U.S. District Court for the Eastern District of Missouri, February 2, 2004, pp. 1-6 (Regarding U.S. Patent Nos. 5,689,100 and 5,956,695)	
	D136	Memorandum and Order, Maritz Inc. and American Express Incentive Services, L.L.C. v. Carlson Companies, Inc. and Carlson Marketing Group, Inc., Cause No. 4:02CV00161CDP, U.S. District Court for the Eastern District of Missouri, March 3, 2004, pp. 1-33 (Regarding U.S. Patent Nos. 5,689,100 and 5,956,695)	
	D137	Docket Report, pp. 1-30, to and including April 2, 2004, for Maritz Inc. and American Express Incentive Services, L.L.C. v. Carlson Companies, Inc. and Carlson Marketing Group, Inc., Cause No. 4:02CV00161CDP, U.S. District Court for the Eastern District of Missouri (Regarding U.S. Patent Nos. 5,689,100 and 5,956,695)	

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APR 09 2004

Examiner Signature		Date Considered	GROUP 3600
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

MARITZ INC. and AMERICAN EXPRESS)
INCENTIVE SERVICES, L.L.C.,)

vs.

Case No. 4:02CV161 CDP

CARLSON COMPANIES, INC.,)
CARLSON MARKETING GROUP, INC.,)
and WILDCARD SYSTEMS, INC.,)

**FIRST AMENDED ANSWER
TO PLAINTIFFS' SECOND AMENDED COMPLAINT**

1. Wildcard is without sufficient information to admit or deny the allegations in paragraph 1 of the Second Amended Complaint and therefore denies them.

2. Wildcard is without sufficient information to admit or deny the allegations in paragraph 2 of the Second Amended Complaint and therefore denies them.

3. Wildcard is without sufficient information to admit or deny the allegations in paragraph 3 of the Second Amended Complaint and therefore denies them.

Jurisdiction and Venue

5. Wildcard admits that plaintiffs allege that patents are infringed and admits

that this Court therefore has subject matter jurisdiction under 28 U.S.C. §§ 1331 and 1338(a). Except as admitted above, Defendant denies the remaining allegations in paragraph 5.

6. Wildcard denies that venue is proper in this judicial district as to the claims against Wildcard.

Count I

7. Wildcard hereby incorporates its responses to paragraphs 1 through 6 above in response to paragraph 7 of the Second Amended Complaint.

8. Wildcard denies that U.S. Patent No. 5,689,100 was duly and legally issued because U.S. Patent No. 5,689,100 is invalid and unenforceable. Further answering, Wildcard otherwise admits the allegations in paragraph 8 of the Second Amended Complaint.

9. Wildcard is without sufficient information to admit or deny the allegations in paragraph 9 of the Second Amended Complaint and therefore denies them.

10. Wildcard denies the allegations in paragraph 10 of the Second Amended Complaint. Further answering, to the extent the allegations in paragraph 10 of the Second Amended Complaint are directed to different defendants, Wildcard cannot respond thereto and therefore denies each and every allegation in paragraph 10 of the Second Amended Complaint.

11. Wildcard denies the allegations in paragraph 11 of the Second Amended Complaint. Further answering, to the extent the allegations in paragraph 11 of the Second Amended Complaint are directed to different defendants, Wildcard cannot

respond thereto and therefore denies each and every allegation in paragraph 11 of the Second Amended Complaint.

12. Wildcard is without sufficient information to admit or deny the allegations in paragraph 12 of the Second Amended Complaint and therefore denies them.

13. Wildcard denies the allegations in paragraph 13 of the Second Amended Complaint. Further answering, to the extent the allegations in paragraph 13 of the Second Amended Complaint are directed to different defendants, Wildcard cannot respond thereto and therefore denies each and every allegation in paragraph 13 of the Second Amended Complaint.

14. Wildcard denies the allegations in paragraph 14 of the Second Amended Complaint.

Count II

15. Wildcard hereby incorporates its responses to paragraphs 1 through 14 above in response to paragraph 15 of the Second Amended Complaint.

16. Wildcard denies that U.S. Patent No. 5,956,695 was duly and legally issued because U.S. Patent No. 5,956,695 is invalid and unenforceable. Further answering, Wildcard otherwise admits the allegations in paragraph 16 of the Second Amended Complaint.

17. Wildcard is without sufficient information to admit or deny the allegations in paragraph 17 of the Second Amended Complaint and therefore denies them.

18. Wildcard denies the allegations in paragraph 18 of the Second Amended Complaint. Further answering, to the extent the allegations in paragraph 18 of the

Second Amended Complaint are directed to different defendants, Wildcard cannot respond thereto and therefore denies each and every allegation in paragraph 18 of the Second Amended Complaint.

19. Wildcard denies the allegations in paragraph 19 of the Second Amended Complaint. Further answering, to the extent the allegations in paragraph 19 of the Second Amended Complaint are directed to different defendants, Wildcard cannot respond thereto and therefore denies each and every allegation in paragraph 19 of the Second Amended Complaint.

20. Wildcard is without sufficient information to admit or deny the allegations in paragraph 20 of the Second Amended Complaint and therefore denies them.

21. Wildcard denies the allegations in paragraph 21 of the Second Amended Complaint. Further answering, to the extent the allegations in paragraph 21 of the Second Amended Complaint are directed to different defendants, Wildcard cannot respond thereto and therefore denies each and every allegation in paragraph 21 of the Second Amended Complaint.

22. Wildcard denies the allegations in paragraph 22 of the Second Amended Complaint.

23. Wildcard denies each and every allegation in the Second Amended Complaint that is not specifically admitted herein.

Additional Defenses

First Defense

1. The Second Amended Complaint fails to state a claim upon which relief

can be granted.

Second Defense

2. Plaintiffs have improperly joined Wildcard to a lawsuit against Carlson Companies, Inc. and Carlson Marketing Group, Inc.

Third Defense

3. Wildcard does not infringe, has not induced infringement, and has not contributed to infringement of any valid claims of U.S. Patent Nos. 5,689,100 or 5,956,695.

Fourth Defense

4. United States Patent Nos. 5,689,100 and 5,956,695 are invalid, unenforceable or void for failure to meet the requirements of patentability found in 35 U.S.C. §§ 102, 103 and 112 because:

a. the alleged inventions are taught by, suggested by, or are obvious in view of the prior art, and no claim of U.S. Patent Nos. 5,689,100 and 5,956,695 can be validly construed to cover any Wildcard process, method, product or system. The differences between the subject matter of said patent claims and the prior art are such that the patent subject matter as a whole would have been obvious at the time the alleged invention was made to a person having an ordinary skill in the art to which the subject matter pertains;

b. The alleged invention of said patent was known or used by others in this country or patented or described in printed publications in this or a foreign country before the alleged invention thereof by the patentee;

c. The alleged invention of said patent was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country, more than one year prior to the date of filing the application for said patent in the United States;

d. Before the alleged invention of the subject matter of said patent by the patentee, the alleged invention was made in this country by another who had not abandoned, suppressed or concealed it;

e. The claims of said patent are invalid for lack of patentable invention.

f. As potentially construed by the Court, the alleged inventions of the patents in suit lack sufficient written description and enabling disclosure, fail to disclose the inventors' best mode, and lack utility.

Fifth Defense

5. United States Patent Nos. 5,689,100 and 5,956,695 are unenforceable due to laches and estoppel.

Sixth Defense

6. United States Patent Nos. 5,689,100 and 5,956,695 are invalid and unenforceable, and plaintiffs should be denied relief, as a result of plaintiffs' or the inventors' actions, including but not limited to patent misuse in claiming protections that would extend beyond those provided by the patent laws, failing to disclose to the United States Patent Office MasterCard's role in the development of the invention, failing to disclose joint inventors from MasterCard, and failing to disclose material prior art including MasterCard's Purchasing Card. Among other things, in a letter dated February

28, 1997, during the prosecution of the application that led to the issuance of the '100 patent, MasterCard disclosed to Maritz that MasterCard's Purchasing Card had the ability to restrict sales by individual merchants (selective authorization) prior to the alleged date(s) of invention of the patents in suit. Furthermore, in the same letter, MasterCard clearly noted that this information contradicted Maritz's claim to the Patent and Trademark Office that selective authorization was nowhere in the prior art. The attorney representing both Maritz and the inventors refused to disclose this prior art. Additionally, during the prosecution of the patent applications, the patent examiner advised the attorney representing Maritz and the inventors of the duty to advise the Examiners if the claims were not jointly owned by each inventor, specifically warning the attorney that he had a duty to advise the Patent and Trademark Office if any claim was not jointly owned so that the applicability of prior art could be considered. The attorney made no such disclosure and allowed the Examiner to evaluate the prior art assuming that each claim was jointly invented by each inventor on the same dates.

Seventh Defense

7. Further answering, on information and belief, and pursuant to Title 35, United States Code, Section 282(4) Defendant states that the patent set forth in the Complaint and the claims thereof are invalid or non-infringed on the following grounds:

- a. The prior art known before the alleged invention of the subject matter of said patent and the disclosure of the patent so limit and restrict the scope of the claims of said patent that nothing made, used or sold by Defendant can be

regarded as an infringement;

b. The United States Patent and Trademark Office improperly issued the 5,689,100 and 5,956,695 patents without due consideration and without full and proper investigation and consideration of all the pertinent art.

c. The patents and publications relied upon as prior art, and persons relied upon as prior inventors or as having prior knowledge or as having previously used or offered the alleged invention for sale, including such patents, publications and persons as are presently unknown to Defendant, will be specified and notice thereof given to Plaintiff in accordance with Title 35, United States Code, Section 282.

Eighth Defense

8. Plaintiffs are precluded from enforcing United States Patent Nos. 5,689,100 or 5,956,695 because Wildcard has prior user rights under 35 U.S.C. § 273 to the subject matter in said patents.

Ninth Defense

9. Plaintiffs are precluded from enforcing United States Patent Nos. 5,689,100 or 5,956,695 because Wildcard has an implied license under said patents.

Tenth Defense

10. This District Court lacks in personam jurisdiction over this Defendant.

Eleventh Defense

11. Plaintiff is precluded by the doctrines of waiver and estoppel from recovering some or all of the damages it seeks because it failed to mitigate them.

WHEREFORE, Defendant asks that the complaint herein be dismissed and that this case be deemed an exceptional case pursuant to Title 35, United States Code, Section 285 with costs and attorney fees awarded to the Defendant.

COUNTERCLAIM FOR DECLARATORY JUDGMENT OF INVALIDITY AND NON-INFRINGEMENT

1. Wildcard incorporates by this reference all of the foregoing allegations and averments of its answer and affirmative defenses.

2. This is an action for declaratory judgment of invalidity and non-infringement. This action arises under the Declaratory Judgment Act, 28 U.S.C. §§ 2201-2202, and the patent laws of the United States, Title 35 United States Code.

3. This Court has jurisdiction over the subject matter of this action under 28 U.S.C. § 1338(a). Venue is based on 28 U.S.C. §§ 1391(b) and (c), or 1400.

4. On November 18, 1997 and November 12, 1997, the United States Patent and Trademark Office issued United States Patent Nos. 5,689,100 and 5,956,695, respectively, with David C. Carrithers, Steven G. Rapp, Gayla L. Stonc, Jody A. Storey-Waller, Kim A. Resch, Kelly K. McGuire, Toni L. Ashby, Mark Jackson, and Lowell Huff as named inventors, and Maritz, Inc., Fenton, Mo. as named assignee.

5. Plaintiffs claim to be the present owner or exclusive licensee of all right, title and interest in and to United States Patent Nos. 5,689,100 and 5,956,695, including

the right to sue and recover damages for infringement.

6. Plaintiffs have asserted that Wildcard has infringed on United States Patent Nos. 5,689,100 and 5,956,695.

7. Wildcard does not infringe the claims of the patent in suit, in any manner, including literally, under the doctrine of equivalents, directly, indirectly, contributorily or otherwise, and has not induced any others to infringe said patents.

8. United States Patent Nos. 5,689,100 and 5,956,695 and each claim thereof are invalid and unenforceable. Maritz failed to disclose to the United States Patent Office MasterCard's role in the development of the invention, joint inventors from MasterCard, and material prior art including MasterCard's Purchasing Card. Among other things, in a letter dated February 28, 1997, during the prosecution of the application that led to the issuance of the '100 patent, MasterCard disclosed to Maritz that MasterCard's Purchasing Card had the ability to restrict sales by individual merchants (selective authorization) prior to the alleged date(s) of invention of the patents in suit. Furthermore, in the same letter, MasterCard clearly noted that this information contradicted Maritz's claim to the Patent and Trademark Office that selective authorization was nowhere in the prior art. The attorney representing both Maritz and the inventors refused to disclose this prior art. He also failed to disclose that all of the inventors allegedly did not jointly invent each of the claims. In addition, United States Patent Nos. 5,689,100 and 5,956,695, as potentially construed by the Court, are invalid and/or unenforceable because, among other things, the inventors and Maritz failed to make an enabling disclosure, failed to provide an adequate written description, failed to disclose their best mode and the patents lack utility.

9. As a consequence of the foregoing and the allegations in the complaint, there is an actual and justiciable controversy between plaintiffs and Wildcard with respect to the validity and infringement of the patent in suit.

10. This action qualifies as an exceptional case supporting an award of reasonable attorneys' fees, costs, and expenses for Wildcard and against plaintiffs pursuant to 35 U.S.C. § 285.

RELIEF REQUESTED

The Court is respectfully requested to:

1. Dismiss Plaintiff's Complaint and enter judgment in Defendant's favor.
2. Enter an order declaring plaintiffs' patents (United States Patent Nos. 5,689,100 and 5,956,695) invalid or unenforceable, and that Wildcard has not infringed, literally or under the doctrine of equivalents, directly, indirectly, contributorily or otherwise, and has not induced any others to infringe, any valid claims of United States Patent Nos. 5,689,100 and 5,956,695.
3. Declare this case to be exceptional and enter an award in Defendant's favor under 35 U.S.C. § 285.
4. Enter an assessment of costs against plaintiffs.
5. Award all other relief that is just and appropriate.

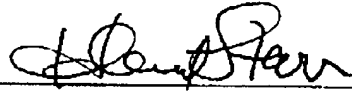
DEMAND FOR JURY TRIAL

Demand for jury trial on Wildcard's counterclaim is hereby made pursuant to Rule 38 of the Federal Rules of Civil Procedure.

Respectfully submitted,

SUELTHAUS & WALSH, P.C.

By:



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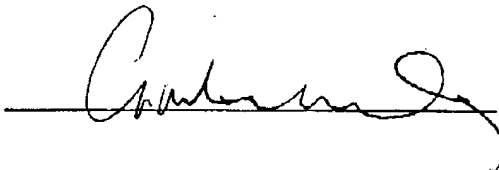
(314) 727-7166 (facsimile)

Attorneys for Defendant Wildcard Systems, Inc.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing document was served upon the following attorneys this 19th day of December 2003 via federal express overnight delivery:

David W. Harlan J. Bennett Clark Robert M. Evans, Jr. Jason M. Schwendt Senniger, Powers, Leavitt & Roedel One Metropolitan Square, 16th Floor St. Louis, Missouri 63012 <i>Attorney for Plaintiffs</i>	John H. Quinn, III Glenn E. Davis Armstrong Teasdale LLP One Metropolitan Square Suite 2600 St. Louis, Missouri 63102-2740 Ronald J. Schutz Emmett J. McMahon Rita Coyle DeMeules Gunnar R. Wieboldt Robins, Kaplan, Miller & Ciresi, L.L.P. 2800 LaSalle Plaza 800 LaSalle Avenue Minneapolis, Minnesota 55402-2740 <i>Attorneys for Defendants Carlson Companies, Inc. and Carlson Marketing Group, Inc.</i>
--	--



Monica Mazur - Activity in Case 4:02-cv-00161-CDP Maritz, Inc., et al v. Carlson Companies, et al "Answer to Amended Complaint"

From: <Moed_AutoSend@moed.uscourts.gov>
To: <MOED_ECF_Notification@moed.uscourts.gov>
Date: 1/13/2004 9:10 AM
Subject: Activity in Case 4:02-cv-00161-CDP Maritz, Inc., et al v. Carlson Companies, et al "Answer to Amended Complaint"

*****NOTE TO PUBLIC ACCESS USERS*** You may view the filed documents once without charge. To avoid later charges, download a copy of each document during this first viewing.**

U.S. District Court

Eastern District of Missouri (LIVE)

Notice of Electronic Filing

The following transaction was received from Helmut M. Starr entered on 1/13/2004 at 8:56 AM CST and filed on 1/13/2004

Case Name: Maritz, Inc., et al v. Carlson Companies, et al
Case Number: 4:02-cv-161
Filer: WildCard Systems Incorporated
Document Number: 121

Docket Text:

ANSWER to Amended Complaint, COUNTERCLAIM against plaintiff all plaintiffs by WildCard Systems Incorporated (LSD,)

The following document(s) are associated with this transaction:

Document description:Main Document

Original filename:n/a

Electronic document Stamp:

[STAMP dcecfStamp_ID=1037221849 [Date=1/13/2004] [FileNumber=516821-0]
[3a87b7dff4df681b81ece64acd9721dc926d0f687704f1660bbec8cd152defc49bc
9d7d388fc4f505ceb5d98e3409c718e752bb328122984f332913cdadc4]]

4:02-cv-161 Notice will be electronically mailed to:

J. Bennett Clark bclark@senniger.com, mmazur@senniger.com

Glenn E. Davis gdavis@armstrongteasdale.com, gdavis541@hotmail.com

Graham L. W. Day gld@suelthauswalsh.com,

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David W. Harlan dharlan@senniger.com, mgriffin@senniger.com

Jeffrey H. Kass jkass@armstrongteasdale.com,

Bryan D. LeMoine bdl@suelthauswalsh.com,

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Helmut M. Starr hms@suelthauswalsh.com,

Gunnar R. Wieboldt grwieboldt@rkmc.com, dmలాfrance@rkmc.com

4:02-cv-161 Notice will not be electronically mailed to:

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MISSOURI
EASTERN DIVISION

FILED

JAN 20 2004

U. S. DISTRICT COURT
EASTERN DISTRICT OF MO

MARITZ, INC. and AMERICAN EXPRESS
INCENTIVE SERVICES, L.L.C.,

Plaintiffs,

vs.

CARLSON COMPANIES, INC.,
CARLSON MARKETING GROUP, INC.,
WILDCARD SYSTEMS, INC.,

Defendants.

Cause No. 4:02CV00161

First Amended Answer and
Counterclaim;
Demand for Jury Trial

FIRST AMENDED ANSWER TO SECOND AMENDED COMPLAINT

Defendants Carlson Companies, Inc. and Carlson Marketing Group, Inc. (collectively "Carlson"), for their Answer to the Second Amended Complaint of Plaintiffs Maritz, Inc. and American Express Incentive Services, L.L.C., state and allege as follows:

Parties

1. Carlson is without sufficient information to admit or deny the allegations of paragraph 1 of the Second Amended Complaint and therefore denies those allegations.
2. Carlson is without sufficient information to admit or deny the allegations of paragraph 2 of the Second Amended Complaint and therefore denies those allegations.
3. Carlson admits the allegations of paragraph 3 of the Second Amended Complaint.
4. Carlson is without sufficient information to admit or deny the allegation of paragraph 4 of the Second Amended Complaint and therefore denies those allegations.

Jurisdiction and Venue

5. Carlson admits that plaintiffs allege that patents are infringed and admit that this Court therefore has subject matter jurisdiction under 28 U.S.C. Sections 1331 and 1338(a). Carlson denies that it has infringed, contributorily infringed, or induced infringement under 35 U.S.C. Section 271. Carlson denies that the Court has personal jurisdiction over Carlson Companies, Inc. and denies all other allegations in paragraph 5 of the Second Amended Complaint.

6. Carlson denies that venue is proper in this judicial district as to the claims against Carlson Companies, Inc.

Count 1

7. Carlson repeats its answer to paragraphs 1 through 6 in response to paragraph 7 of the Second Amended Complaint.

8. Carlson denies that U.S. Patent No. 5,689,100 was duly and legally issued because U.S. Patent No. 5,689,100 is invalid and unenforceable. Carlson otherwise admits the allegations in paragraph 8 of the Second Amended Complaint.

9. Carlson is without sufficient information to admit or deny the allegations in paragraph 9 of the Second Amended Complaint and therefore denies those allegations.

10. Carlson denies the allegations in paragraph 10 of the Second Amended Complaint. Moreover, to the extent the allegations in paragraph 10 of Second Amended Complaint are directed to a different defendant, Carlson cannot respond thereto and therefore denies each and every allegation in paragraph 10 of the Second Amended Complaint.

11. Carlson denies the allegations in paragraph 11 of the Second Amended Complaint. Moreover, to the extent the allegations in paragraph 11 of Second Amended

Complaint are directed to a different defendant, Carlson cannot respond thereto and therefore denies each and every allegation in paragraph 11 of the Second Amended Complaint.

12. Carlson is without sufficient information to admit or deny the allegations in paragraph 12 of the Second Amended Complaint and therefore denies those allegations.

13. Carlson denies the allegations in paragraph 13 of the Second Amended Complaint. Moreover, to the extent the allegations in paragraph 13 of Second Amended Complaint are directed to a different defendant, Carlson cannot respond thereto and therefore denies each and every allegation in paragraph 13 of the Second Amended Complaint.

14. Carlson denies the allegations in paragraph 14 of the Second Amended Complaint.

Count II

15. Carlson repeats its answer to paragraphs 1 through 14 in response to paragraph 15 of the Second Amended Complaint.

16. Carlson denies that U.S. Patent No. 5,956,695 was duly and legally issued because U.S. Patent No. 5,956,695 is invalid and unenforceable. Carlson otherwise admits the allegations in paragraph 16 of the Second Amended Complaint.

17. Carlson is without sufficient information to admit or deny the allegations in paragraph 17 of the Second Amended Complaint and therefore denies those allegations.

18. Carlson denies the allegations in paragraph 18 of the Second Amended Complaint. Moreover, to the extent the allegations in paragraph 18 of Second Amended Complaint are directed to a different defendant, Carlson cannot respond thereto and therefore denies each and every allegation in paragraph 18 of the Second Amended Complaint.

19. Carlson denies the allegations in paragraph 19 of the Second Amended Complaint. Moreover, to the extent the allegations in paragraph 19 of Second Amended Complaint are directed to a different defendant, Carlson cannot respond thereto and therefore denies each and every allegation in paragraph 19 of the Second Amended Complaint.

20. Carlson is without sufficient information to admit or deny the allegations in paragraph 20 of the Second Amended Complaint and therefore denies those allegations.

21. Carlson denies the allegations in paragraph 21 of the Second Amended Complaint. Moreover, to the extent the allegations in paragraph 21 of Second Amended Complaint are directed to a different defendant, Carlson cannot respond thereto and therefore denies each and every allegation in paragraph 21 of the Second Amended Complaint.

22. Carlson denies the allegations in paragraph 22 of the Second Amended Complaint.

23. Carlson denies each and every allegation in the Second Amended Complaint that is not specifically admitted herein.

Affirmative Defenses

24. The Second Amended Complaint fails to state a claim upon which relief can be granted.

25. Plaintiffs have improperly joined Carlson to a lawsuit against Wildcard Systems, Inc.

26. Carlson does not infringe, has not induced infringement, and has not contributed to infringement of any valid claims of U.S. Patent Nos. 5,689,100 or 5,956,695.

27. United States Patent Nos. 5,689,100 and 5,956,695 are invalid, unenforceable and/or void for failure to meet the requirements of patentability found in 35 U.S.C. Sections 102,

103 and 112 because the alleged inventions thereof are taught by, suggested by, and/or are obvious in view of the prior art, because as potentially construed by the Court, they lack sufficient written description and enabling disclosure, they fail to disclose the inventors' best mode, and lack utility, and no claim of U.S. Patent Nos. 5,689,100 and 5,956,695 can be validly construed to cover any Carlson process, method, product or system.

28. United States Patent Nos. 5,689,100 and 5,956,695 are unenforceable due to laches and estoppel.

29. United States Patent Nos. 5,689,100 and 5,956,695 are invalid and unenforceable, and plaintiffs should be denied relief, as a result of plaintiffs' or the inventor's actions including patent misuse in claiming copyright protections that would extend beyond those provided by the patent laws, failing to disclose to the United States Patent Office MasterCard's role in the development of the invention, failing to disclose joint inventors from MasterCard, and failing to disclose material prior art including MasterCard's Purchasing Card. Among other things, in a letter dated February 28, 1997, during the prosecution of the application that led to the issuance of the '100 patent, MasterCard disclosed to Maritz that MasterCard's Purchasing Card had the ability to restrict sales by individual merchants (selective authorization) prior to the alleged date(s) of invention of the patents in suit. Furthermore, in the same letter, MasterCard clearly noted that this information contradicted Maritz's claim to the Patent and Trademark Office that selective authorization was nowhere in the prior art. The attorney representing both Maritz and the inventors refused to disclose this prior art. Additionally, during the prosecution of the patent applications, the patent examiner advised the attorney representing Maritz and the inventors of the duty to advise the examiners if the claims were not jointly owned by each inventor, specifically warning the attorney that he had a duty to advise the Patent and Trademark Office if

any claim was not jointly owned so that the applicability of prior art could be considered. The attorney made no such disclosure and allowed the examiner to evaluate the prior art assuming that each claim was jointly invented by each inventor on the same dates.

30. Plaintiffs are precluded from enforcing United States Patent Nos. 5,689,100 or 5,956,695 because Carlson has prior user rights under 35 U.S.C. §273 to the subject matter claimed in said patents.

31. Plaintiffs are precluded from enforcing United States Patent Nos. 5,689,100 or 5,956,695 because Carlson has an implied license under said patents.

COUNTERCLAIM
DECLARATORY JUDGMENT OF
INVALIDITY AND NON-INFRINGEMENT

Defendant Carlson Marketing Group, Inc. ("CMG"), for its Counterclaim against Maritz and AEIS, herein alleges as follows:

32. This is an action for a declaratory judgment, together with such further relief based thereon as may be necessary or proper, pursuant to the Federal Declaratory Judgment Act, 28 U.S.C. Sections 2201, 2202. There is an actual controversy between plaintiffs and CMG arising under the United States patent laws, Title 35 of the United States Code.

33. This counterclaim arises under the Patent Laws of the United States, Title 35, United States Code. The subject matter jurisdiction of this Court is founded upon Title 28, United States Code section 1338. Venue within this judicial district is proper under Title 28, United States Code sections 1391(b), 1391(c) and/or 1400.

34. Plaintiffs Maritz and AEIS allege that they are the owners and/or exclusive licensees of United States Patent Nos. 5,689,100 and 5,956,695. Maritz and AEIS contend that some of Carlson's incentive programs, processes or methods infringe claims of United States Patent Nos. 5,689,100 and 5,956,695.

35. United States Patent Nos. 5,689,100 and 5,956,695 and each claim thereof are invalid, unenforceable and not infringed by Carlson. Maritz failed to disclose to the United States Patent Office MasterCard's role in the development of the invention, joint inventors from MasterCard, and material prior art including MasterCard's Purchasing Card. Among other things, in a letter dated February 28, 1997, during the prosecution of the application that led to the issuance of the '100 patent, MasterCard disclosed to Maritz that MasterCard's Purchasing Card had the ability to restrict sales by individual merchants (selective authorization) prior to the alleged date(s) of invention of the patents in suit. Furthermore, in the same letter, MasterCard clearly noted that this information contradicted Maritz's claim to the Patent and Trademark Office that selective authorization was nowhere in the prior art. The attorney representing both Maritz and the inventors refused to disclose this prior art. He also failed to disclose that all of the inventors allegedly did not jointly invent each of the claims. In addition, United States Patent Nos. 5,689,100 and 5,956,695, as potentially construed by the Court, are invalid and/or unenforceable because, among other things, the inventors and Maritz failed to make an enabling disclosure, failed to provide an adequate written description, failed to disclose their best mode and the patents lack utility.

36. Carlson has not infringed any valid claims of U.S. Patent Nos. 5,689,100 or 5,956,695, either directly, indirectly, contributorily or otherwise, and has not induced any others to infringe said patents.

37. CMG therefore seeks a declaration and finding by this Court that it does not infringe, directly, indirectly, contributorily or otherwise, and has not induced any others to infringe, any valid claims of U.S. Patent Nos. 5,689,100 or 5,956,695.

WHEREFORE, Carlson prays for the following relief:

A. That Maritz and ADS take nothing by their Second Amended Complaint and their claims against Carlson be dismissed with prejudice;

B. That Carlson be found not to infringe, either directly, indirectly, contributorily or otherwise, and be found not to have induced infringement of any valid claims of United States Patents No. 5,689,100 and 5,956,695;

C. That United States Patents No. 5,689,100 and 5,956,695 be found invalid and unenforceable;

D. That this matter be deemed an exceptional case pursuant to 35 U.S.C. § 285;

E. That Carlson be awarded its costs, fees, and expenses in this action; and

F. That Carlson be awarded such other and further relief as this Court may deem just, equitable and proper under the circumstances.

JURY TRIAL DEMAND

Pursuant to Rule 38 of the Federal Rules of Civil Procedure, Carlson hereby demands a jury trial on all issues so triable.

Dated this ____ day of December, 2003.

ROBINS, KAPLAN, MILLER & CIRESI L.L.P.

By: _____

Ronald J. Schutz
Emmett J. McMahon
Rita Coyle DeMeules
Gunnar R. Wieboldt

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612-349-8500

ARMSTRONG TEASDALE LLP

By: _____

John H. Quinn III, #4110

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314-621-5070

**ATTORNEYS FOR CARLSON COMPANIES,
INC. AND CARLSON MARKETING GROUP,
INC.**

Monica Mazur - Activity in Case 4:02-cv-00161-CDP Maritz, Inc., et al v. Carlson Companies, et al "Answer to Amended Complaint"

From: <Moed_AutoSend@moed.uscourts.gov>
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Subject: Activity in Case 4:02-cv-00161-CDP Maritz, Inc., et al v. Carlson Companies, et al "Answer to Amended Complaint"

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U.S. District Court

Eastern District of Missouri (LIVE)

Notice of Electronic Filing

The following transaction was received from Gunnar R. Wieboldt entered on 1/21/2004 at 3:23 PM CST and filed on 1/20/2004

Case Name: Maritz, Inc., et al v. Carlson Companies, et al
Case Number: 4:02-cv-161
Filer: Carlson Marketing Group, Inc.
Carlson Companies, Inc.

Document Number: 125

Docket Text:

FIRST AMENDED ANSWER to Second Amended Complaint, COUNTERCLAIM against plaintiff American Express Incentive Services, L.L.C., Maritz, Inc. by Carlson Companies, Inc., Carlson Marketing Group, Inc.(LSD,)

The following document(s) are associated with this transaction:

Document description:Main Document

Original filename:n/a

Electronic document Stamp:

[STAMP dcecfStamp_ID=1037221849 [Date=1/21/2004] [FileNumber=526611-0]
[8401a080aaa7ee979c67354277de4d78a9bea201f4aacb23e5da0fb5e221f98d6ce9
0f59d4382f134bc5670b23c43fe08fc3aead655d7c923ae60172173a4a61]]

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4:02-cv-161 Notice will not be electronically mailed to:

4. Plaintiffs admit that on November 18, 1997 the United States Patent and Trademark Office issued United States Patent No. 5,689,100 with David C. Carrithers, Steven G. Rapp, Gayla L. Stone, Jody A. Storey-Waller, Kim A. Resch, Kelly K. McGuire, Toni L. Ashby, Mark Jackson, and Lowell Huff as named inventors, that United States Patent No. 5,956,695 was issued with the same named inventors, and that both patents are assigned to Maritz Inc. of Fenton, Missouri. Plaintiffs deny the remaining allegations of Paragraph 4.

5. Plaintiffs admit that Maritz Inc. is the owner by assignment of United States Patent Nos. 5,689,100 and 5,956,695 and that American Express Incentive Services, L.L.C. is an exclusive licensee of United States Patent Nos. 5,689,100 and 5,956,695 for the field of use consisting of corporate incentive business. Plaintiffs further admit that Maritz Inc. and American Express Incentive Services, L.L.C. hold all right to sue and recover damages for infringement of United States Patent Nos. 5,689,100 and 5,956,695.

6. Plaintiffs admit the allegations contained in Paragraph 6 of Wildcard's First Amended Counterclaim.

7. Plaintiffs deny each and every allegation contained in Paragraph 7 of WildCard's First Amended Counterclaim.

8. Plaintiffs admit that, during the prosecution of the application that led to the issuance of the '100 patent, Maritz received a letter from MasterCard dated February 28, 1997, and state that the letter speaks for itself. Plaintiffs deny the remaining allegations of Paragraph 8.

9. Plaintiffs admit that WildCard purports to assert an action for declaratory judgment and that a controversy exists on account of the acts of infringement of WildCard and

the remaining defendants. Plaintiffs deny each and every allegation contained in Paragraph 8 of WildCard's First Amended Counterclaim which is not admitted.

10. Plaintiffs deny each and every allegation contained in Paragraph 10 of WildCard's First Amended Counterclaim.

AFFIRMATIVE DEFENSES

11. WildCard's First Amended Counterclaim fails to state a claim upon which relief can be granted.

12. U.S. Patent Numbers 5,689,100 and 5,956,695 are valid, enforceable, and infringed by WildCard, which does not hold a license or prior user rights in or to such patents or the subject matter thereof, which infringement has caused Plaintiffs compensable damages.

WHEREFORE, Plaintiffs Maritz Inc. and American Express Incentive Services, L.L.C. pray for judgment that:

- a. WildCard's First Amended Counterclaim be dismissed with prejudice and Wild Card take nothing by it;
- b. WildCard, along with Carlson Companies, Inc., and Carlson Marketing Group, Inc. (collectively "Defendants"), be found to have willfully infringed U.S. Patent Nos. 5,689,100 and 5,956,695, and that they and each of their respective officers, agents, servants, employees, and attorneys, and all of those persons in active concert or participation with them, be enjoined permanently from infringing, inducing infringement of, and/or contributing to the infringement of U.S. Patent Nos. 5,689,100 and 6,956,695;

- c. Plaintiffs be awarded actual damages for the infringement against Defendants, jointly and severally, accrued through the time of trial, and that these damages be trebled;
- d. Plaintiffs be awarded prejudgment and post-judgment interest against Defendants, jointly and severally;
- e. Plaintiffs' costs be assessed against Defendants, jointly and severally;
- f. This case be deemed exceptional and Plaintiffs be awarded their reasonable attorneys' fees pursuant to 35 U.S.C. §273(b)(8) and 35 U.S.C. §285; and
- g. Plaintiffs be awarded such other and further relief as the Court may deem just and proper.

SENNIGER POWERS, LEAVITT & ROEDEL

By 

David W. Harlan, #3322
J. Bennett Clark, #17440
Robert M. Evans, Jr., #3078
Jason M. Schwent, #109196
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
(314) 231-5400
(314) 231-4342 (Facsimile)

Attorneys for Plaintiffs Maritz Inc. and American
Express Incentive Services, L.L.C.

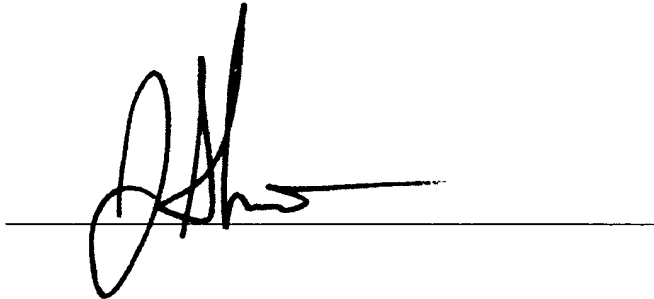
CERTIFICATE OF SERVICE

I hereby certify that on January 28, 2004, the foregoing was filed electronically with the Clerk of Court to be served by operation of the Court's electronic filing system upon the following: Glenn E. Davis, Esq., Graham L. W. Day, Esq., Jeffrey H. Kass, Esq., Bryan D. LeMoine, Esq., Eleanor A. Maynard, Esq., John H. Quinn, Esq., and Helmut M. Starr, Esq.

I hereby certify that on January 26, 2004, the foregoing was mailed by United States Postal Service to the following non-participants in Electronic Case Filing:

Ronald J. Schutz Esq.
Emmett J. McMahon Esq.
Rita Coyle DeMeules Esq.
Gunnar R. Wieboldt Esq.
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Minneapolis, MN 55402-2015

Counsel for Defendants



UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MISSOURI
EASTERN DIVISION

MARITZ, INC., et al.,)	
)	
Plaintiffs,)	
)	
vs.)	Case No. 4:02CV161 CDP
)	
CARLSON COMPANIES, INC.,)	
et al.,)	
)	
Defendants.)	

AMENDED CASE MANAGEMENT ORDER

Upon consideration,

IT IS HEREBY ORDERED that the parties' request to modify the Third Amended Case Management Order [# 127] is granted. The deadlines in this case are modified in the following respects:

1. **Expert Witnesses:**

(a) Expert witness disclosures and reports shall be made no later than **April 9, 2004;**

(b) Rebuttal expert disclosures and reports shall be made no later than **May 7, 2004;**

(c) Experts shall be made available for depositions no later than **May 21, 2004.**

2. All discovery in this case shall be completed in this case no later than **May 21, 2004.**

3. The motion package rule, E.D.Mo.L.R. 4.05, shall no longer apply. Any motion to dismiss, motion for summary judgment or motion for judgment on the pleadings shall be filed no later than **June 9, 2004**. Opposition briefs shall be filed no later than **June 30, 2004**, and any reply brief may be filed no later than **July 16, 2004**.

4. This case is removed from the **July 5, 2004** docket and set for a jury trial on **October 25, 2004 at 9:00 A.M.** This is a two-week docket.

IT IS FURTHER ORDERED that Maritz's unopposed motion to file its first amended reply to Wildcard's first amended counterclaim [# 128] is granted.

A handwritten signature in cursive script, reading "Catherine D. Perry", written in black ink.

CATHERINE D. PERRY
UNITED STATES DISTRICT JUDGE

Dated this 30th day of January, 2004.

Monica Mazur - Activity in Case 4:02-cv-00161-CDP Maritz, Inc., et al v. Carlson Companies, et al "Case Management Order - Amended"

From: <Moed_AutoSend@moed.uscourts.gov>
To: <MOED_ECF_Notification@moed.uscourts.gov>
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Subject: Activity in Case 4:02-cv-00161-CDP Maritz, Inc., et al v. Carlson Companies, et al "Case Management Order - Amended"

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U.S. District Court

Eastern District of Missouri (LIVE)

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Case Name: Maritz, Inc., et al v. Carlson Companies, et al
Case Number: 4:02-cv-161
Filer:
Document Number: 129

Docket Text:

AMENDED CASE MANAGEMENT ORDER[127] Joint MOTION to Amend/Correct [123] Case Management Order - Amended,, filed by Maritz, Inc., American Express Incentive Services, L.L.C., [128] MOTION for Leave to File First Amended Reply to WildCard's First Amended Counterclaim filed by Maritz, Inc., American Express Incentive Services, L.L.C. motion are GRANTED. Dispositive Motions due by 6/9/2004. Jury Trial reset for 10/25/2004 09:00 AM in Courtroom 14S before Honorable Catherine D. Perry. (see order for further details). Signed by Judge Catherine D. Perry on 1/30/04. (BAK,)

The following document(s) are associated with this transaction:

Document description:Main Document

Original filename:n/a

Electronic document Stamp:

[STAMP dcecfStamp_ID=1037221849 [Date=1/30/2004] [FileNumber=538251-0]
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a08bdc0c2f93aebdccfc11b663e977029d1e998b42e3c8c68ed25496d86f]]

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4:02-cv-161 Notice will not be electronically mailed to:

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MISSOURI
EASTERN DIVISION

MARITZ INC. and AMERICAN EXPRESS
INCENTIVE SERVICES, L.L.C.,

Plaintiffs,

vs.

CARLSON COMPANIES, INC.,
CARLSON MARKETING GROUP, INC.,
and WILDCARD SYSTEMS, INC.,

Defendants.

Cause No. 4:02CV00161CDP

REPLY TO THE CARLSON DEFENDANTS' FIRST AMENDED COUNTERCLAIM

Plaintiffs Maritz Inc. and American Express Incentive Services, L.L.C. (hereinafter collectively "Plaintiffs"), for their Reply to the First Amended Counterclaim of defendants Carlson Companies, Inc. and Carlson Marketing Group, Inc. (hereinafter collectively "Defendants"), state as follows:

32. Plaintiffs admit that Defendants purport to assert an action for declaratory judgment. Plaintiffs deny the legitimacy of the Counterclaim and deny any remaining allegations contained in Paragraph 32 of the Counterclaim.

33. Plaintiffs admit the allegations contained in Paragraph 33 of the Counterclaim.

34. Plaintiffs admit the allegations contained in Paragraph 34 of the Counterclaim.

35. Plaintiffs admit that, during the prosecution of the application which led to the issuance of the '100 patent, Maritz received a letter dated February 28, 1997, and state that the

letter speaks for itself. Plaintiffs deny the remaining allegations contained in Paragraph 35 of the Counterclaim.

36. Plaintiffs deny each and every allegation contained in Paragraph 36 of the Counterclaim.

37. Plaintiffs admit that Defendants are seeking declaratory relief. Plaintiffs deny each and every remaining allegation contained in Paragraph 37.

AFFIRMATIVE DEFENSES

38. Defendants' Counterclaim fails to state a claim upon which relief can be granted.

39. U.S. Pat. Nos. 5,689,100 and 5,956,695 are valid, enforceable, and infringed by Defendants.

WHEREFORE, Plaintiffs Maritz Inc. and American Express Incentive Services, L.L.C. pray for judgment that:

- a. The Counterclaim be dismissed with prejudice and Defendants Carlson Companies, Inc. and Carlson Marketing Group, Inc. take nothing by it;
- b. Defendants Carlson Companies, Inc. and Carlson Marketing Group, Inc. be found to have willfully infringed U.S. Patent Nos. 5,689,100 and 5,956,695, and that they and each of their respective officers, agents, servants, employees, and attorneys, and all of those persons in active concert or participation with them, be enjoined permanently from infringing, inducing infringement of, and/or contributing to the infringement of U.S. Patent Nos. 5,689,100 and 5,956,695;
- c. An award of actual damages be entered in favor of Plaintiffs and against said

Defendants, jointly and severally, accrued through the time of trial, and that these damages be trebled;

- d. Plaintiffs be awarded prejudgment and post-judgment interest against Defendants, jointly and severally;
- e. Plaintiffs' costs be assessed against Defendants, jointly and severally;
- f. This case be deemed exceptional and Plaintiffs be awarded their reasonable attorneys' fees pursuant to 35 U.S.C. §273(b)(8) and 35 U.S.C. §285; and
- g. Plaintiffs be awarded such other and further relief as the Court may deem just and proper.

Respectfully submitted,

SENNIGER, POWERS, LEAVITT & ROEDEL

By 

David W. Harlan, #3322

J. Bennett Clark, #17440

Robert M. Evans, Jr., #3078

Jason M. Schwent, #109,196

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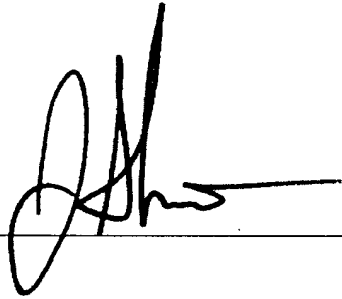
Attorneys for Plaintiffs Maritz Inc. and American
Express Incentive Services, L.L.C.

CERTIFICATE OF SERVICE

I hereby certify that on February 2, 2004, the foregoing was filed electronically with the Clerk of Court to be served by operation of the Court's electronic filing system upon the following: Glenn E. Davis, Esq., Graham L. W. Day, Esq., Jeffrey H. Kass, Esq., Bryan D. LeMoine, Esq., Eleanor A. Maynard, Esq., John H. Quinn, Esq., and Helmut M. Starr, Esq.

I hereby certify that on February 2, 2004, the foregoing was mailed by United States Postal Service to the following non-participants in Electronic Case Filing:

Ronald J. Schutz Esq.
Emmett J. McMahon Esq.
Karl S. Nastro Esq.
Robins, Kaplan, Miller & Ciresi L.L.P.
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A handwritten signature in black ink, appearing to read "R. Schutz", is written over a horizontal line.

Other Answers

4:02-cv-00161-CDP Maritz, Inc., et al v. Carlson Companies, et al

U.S. District Court

Eastern District of Missouri (LIVE)

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American Express Incentive Services, L.L.C.

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ANSWER TO CLAIM and REPLY TO AFFIRMATIVE DEFENSES of *Carlson Defendants* by Plaintiffs American Express Incentive Services, L.L.C., Maritz, Inc., Counter Defendants American Express Incentive Services, L.L.C., Maritz, Inc. by Plaintiffs American Express Incentive Services, L.L.C., Maritz, Inc., Counter Defendants American Express Incentive Services, L.L.C., Maritz, Inc.. (Schwent, Jason)

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UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MISSOURI
EASTERN DIVISION

MARITZ, INC., et al.,)	
)	
Plaintiffs,)	
)	
vs.)	Case No. 4:02CV161 CDP
)	
CARLSON COMPANIES, INC.,)	
et al.,)	
)	
Defendants.)	

MEMORANDUM AND ORDER

Plaintiff Maritz, Inc., is the owner of two patents relating to computer systems used in the incentive industry. Plaintiff American Express Incentive Services is the exclusive licensee of these patents. Plaintiffs claim that defendants Carlson Companies, Carlson Marketing Group and Wildcard Systems are infringing the patents. The matter is presently before me for claims construction.

I. Factual Background

The inventions disclosed in the patents are computer programs that generally rely on a filter processor (or filter means) that, once a transaction is initiated by a merchant through a credit/debit card network, identifies participants in an incentive award program (or, more broadly, a program). The filter processor additionally checks to see if the merchant is a participant in the program and whether the

participant has a sufficient balance to cover the proposed transaction. If the response is positive on both of these inquiries, the filter processor generates validating data and approves the transaction. If not, the filter processor generates invalidating data and does not approve the transaction.

Patent 5,689,100 was issued November 18, 1997, and is titled “Debit Card System and Method for Implementing Incentive Award Program.” Plaintiffs assert that defendants infringe claims 1, 6, 7, 8, 9, 13, 14, 15 and 16 of the ‘100 patent.

Patent 5,956,695 was issued September 21, 1999, and is titled “Filter Processor and Method for Implementing a Program.” Plaintiffs assert that defendants infringe claims 14, 15, 23, 25, 26 and 28 of the ‘695 patent.

In the ‘100 patent, claims 1, 13, 15 and 16 are independent claims, and the others are dependent. In the ‘695 patent, claims 14, 23 and 26 are independent claims, while 14, 24, 25 and 28 are dependent. Claims 13 of the ‘100 patent and 14 and 26 of the ‘695 patent are method claims. Independent claims 1, 15 and 16 of the ‘100 patent and 23 of the ‘695 patent use means-plus-function language.

The parties have provided some agreed definitions of terms, and those agreed definitions will be used in the jury instructions to be given at trial.

The parties initially identified construction disputes with regard to 47 claim terms, but they have now “narrowed” their disputes to approximately 37 issues,

depending on how you count them. They also do not agree on whether now is an appropriate time to describe the structures for the means-plus-function claims. Maritz presented evidence on structure and proposed a correspondence chart. Carlson challenges that construction but has not provided any alternative proposal. Finally, with regard to independent claim 13 and dependent claim 14 of the '100 patent, the parties disagree about whether certain language is a typographical error that can be ignored or is a part of the claim that must be construed.

II. Legal Standards Governing Claim Construction

Claim construction is a matter of law. Markman v. Westview Instruments, Inc., 517 U.S. 370, 388-89 (1996). In construing a claim, a court looks first to the intrinsic evidence of record, that is, the claim's language, the specification and the prosecution history. Vitronics Corp. v. Conception, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996). Intrinsic evidence is "the most significant source of the legally operative meaning of disputed claim language." Id.

The "appropriate starting point" in construing patent claims is always the claim language itself. Comark Communications, Inc. v. Harris Corp., 156 F.3d 1182, 1186 (Fed. Cir. 1998). The words of a claim are generally given "their ordinary and customary meaning." Vitronics Corp., 90 F.3d at 1582. Dictionaries are always available to the Court to determine such meanings of disputed claim

terms, because such sources represent the unbiased reflections of common understanding. Texas Digital Sys. v. Telegenix, Inc., 308 F.3d 1193, 1202-03 (Fed. Cir. 2002). Claims are interpreted in light of the specification and with the knowledge of one with ordinary skill in the art. Id., at 1582.

A patentee may act as her own lexicographer and assign a special definition to a word, so long as that definition is clearly stated in the patent specification or prosecution history. Id. To determine whether a patentee has used any terms in a manner inconsistent with their ordinary meaning, a court must review the specification, which is usually “dispositive” and always “highly relevant” to the claim construction analysis. Vitronics Corp., 90 F.3d at 1582. Adopting a construction that would not cover preferred embodiments and examples described in the specification is rarely, if ever, correct. Id. at 1583.

A court may also consider the patent’s prosecution history, which contains “the complete record of all the proceedings before the Patent and Trademark Office, including any express representations made by the applicant regarding the scope of the claims.” Id. Indeed, the prosecution history is of primary significance in understanding the claims. Markman, 52 F.3d at 980. However, although the prosecution history is always relevant to claim construction, it cannot be used to infer the intentional narrowing of a claim term, unless there has been a “clear

disavowal” of the claim coverage. Amgen, Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1327 (Fed. Cir. 2003). An example of such clear disavowal is when the applicant amends a claim to overcome a rejection by the Examiner. Id.

Extrinsic evidence, i.e., evidence that is external to the patent and prosecution history, is not to be consulted when the intrinsic evidence is unequivocal. Bell & Howell Document Mgmt. Prods. Co. v. Altek Sys., 132 F.3d 701, 706 (Fed. Cir. 1997); Vitronics Corp., 90 F.3d at 1583 (“[W]here the public record unambiguously describes the scope of the patented invention, reliance on any extrinsic evidence is improper.”); but see Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1308 (Fed. Cir. 1999) (“[I]t is entirely appropriate, perhaps even preferable, for a court to consult trustworthy extrinsic evidence to ensure that the claim construction . . . is not inconsistent with clearly expressed, plainly apposite and widely held understandings in the pertinent technical field.”).

Several claims of the patents at issue are written in means-plus-function format. 35 U.S.C. § 112, ¶ 6 allows patent applicants to use means-plus-function language to claim an element functionally, without reciting structures for performing those functions. Envirco Corp. v. Clestra Cleanroom, Inc., 209 F.3d 1360, 1364 (Fed. Cir. 2000). “As is the case with other aspects of patent law, e.g. obviousness, a proper determination of whether the claim limitations should be construed as

means-plus-function limitations requires an understanding of one of ordinary skill in the art.” Apex, Inc. v. Raritan Computer, Inc., 325 F.3d 1364, 1374 (Fed. Cir. 2003).

Whether 35 U.S.C. § 112, ¶ 6 applies is a question of law. When a claim limitation uses the word ‘means’, a rebuttable presumption arises that § 112, ¶ 6 applies to the limitation; conversely, a claim term that does not use ‘means’ will trigger the rebuttable presumption that § 112, ¶ 6 does not apply. CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359, 1369 (Fed. Cir. 2002). The term ‘means’ is central to the analysis. Personalized Media Communications v. Int’l Trade Comm’n, 161 F.3d 696, 703 (Fed. Cir. 1998). When a claim uses the term ‘means,’ the focus is on whether the claim term recites no function corresponding to that means or whether the claim recites sufficient structure or material for performing that function. Rodime PLC v. Seagate Tech., Inc., 174 F.3d 1294, 1302 (Fed.Cir.1999).

If a patent claim written in means-plus-function format fails to disclose an adequate structure corresponding to the recited function in accordance with 35 U.S.C. § 112, ¶ 1, the claim is of indefinite scope, and invalid under 35 U.S.C. § 112, ¶ 2. In re Dossel, 115 F.3d 942, 945 (Fed. Cir. 1997). The Court of Appeals for the Federal Circuit treats challenges to whether a claim discloses a sufficient

structure as a matter of claim construction. See, e.g., Apex, 325 F.3d at 1371-72; Rudde v. Harley-Davidson, Inc., 250 F.3d 1369, 1376-77 (Fed. Cir. 2001). “[A] challenge to a claim containing a means-plus-function limitation as lacking structural support requires a finding, by clear and convincing evidence, that the specification lacks disclosure of structure sufficient to be understood by one skilled in the art as being adequate to perform the recited function.” Rudde, 325 F.3d at 1376-77.

III. Discussion

A. Means-Plus-Function Claims

Maritz defines some claim terms in a means-plus-function manner, and it offered expert testimony regarding the corresponding structure. It also provided a correspondence chart with its proposed jury instructions. Carlson did not offer its own definition of the means-plus-function language, nor did it provide any alternative correspondence chart. Instead, Carlson argues that the language of these claims fails to disclose an adequate structure for the claimed function, and also argues that this is a fact issue to be decided at a later point in these proceedings.

Maritz offered the testimony of Dr. Morley as an expert on the level of skill in the art and to testify on means-plus-function issues and definiteness. According to Dr. Morley, one of ordinary skill in the art would be able to create, from the structures disclosed in the specifications, the necessary computer program to

perform the evaluation process of the invention without experimentation. Morley also explained what structure the patent specification disclosed for each mean-plus-function element.

Carlson argues that the sufficiency of the structure disclosed is an issue about which there is a question of fact, which cannot be decided now. I disagree. The Court of Appeals for the Federal Circuit treats challenges to whether a claim discloses a sufficient structure as a matter of claim construction, and I believe it is appropriate to decide that issue now. See, e.g., Apex, 325 F.3d at 1371-72; Rudde v. Harley-Davidson, Inc., 250 F.3d 1369, 1376-77 (Fed. Cir. 2001). After considering the evidence submitted, I conclude that corresponding structure to the challenged means-plus-function language is sufficiently revealed in the specification. Additionally, I agree with Maritz that its proposed correspondence chart adequately discloses the structure for each of the means-plus-function elements, so I will incorporate that chart into the jury instructions that will be used at trial.¹

B. Specific Claims Disputes

As to the remaining claims, Carlson seeks to add a number of limitations to

¹At the Markman hearing I told the lawyers that I had never submitted a means-plus-function claim to a jury before; that is no longer true. At trial we will use Maritz's proposed correspondence chart (minus its references to the briefs and testimony) along with an appropriate explanation such as that included as Maritz's exhibit 3 to its Post-Markman brief.

the claims that are neither apparent from the text nor supported by prosecution history showing a clear disavowal of Maritz's proposed claim scope. I will reject this approach. Below is a general discussion of the disputed claim terms and the reasons why I chose such a construction, followed later by my specific order construing these terms. In the interest of brevity I have not tried to detail all my reasons here; in general, I agree with Maritz's arguments.

1. "debit cards" (claims 1, 6, 7, 8, 15 and 16 of the '100 patent)

Maritz offers a definition of debit cards as "cards used to authorize, through electronic means, a reduction of an existing account balance and the transfer of payment from an account to another account, often in connection with a purchase." Carlson agrees with this interpretation, except that it wishes to add that "reduction of an existing account balance" must be from a "demand deposit account" (DDA).

Carlson's DDA requirement unduly ties the debit card to a direct deposit account at a bank. Neither the specifications nor the prosecution history supports adding this limitation to the definition. In several instances in the prosecution history, Maritz distanced its invention from one specifically tied to demand deposit accounts. For instance, the "description of the preferred embodiment" in both patents notes:

As various changes could be made in the above products and methods without departing from the scope of the invention, it is intended that all matter contained in the above description and shown in the accompanying drawings shall be interpreted as illustrative and not in a limiting sense.

‘100 Pat., col. 10, ll. 42-46; ‘695 Pat., col. 10, ll. 43-47. Additionally, the specification includes the following description of a debit card:

A debit card offers the services of an account from which funds or points can be withdrawn without the need for paper to effectuate the debit transaction. It is an electronic account that transfers amounts from one account to another as a holder of the card uses the card to make purchases.

‘100 Pat., col. 4, ll. 49-53. Because Maritz did not clearly disavow the claim scope or otherwise link its debit card to a demand deposit account, I will adopt Maritz’s proposed definition.

2. “credit/debit card network” (claims 1, 15 and 16 of the ‘100 patent and claims 14, 23 and 26 of the ‘695 patent)

As used in all claims of both patents, Maritz defines the term as “a system of one or more computers and/or processors which process, or are capable of processing, credit and debit card transactions. The Mastercard and Visa networks are examples of such networks.” I will adopt Maritz’s dictionary definitions, except for the example of the Mastercard and Visa networks, which are not essential to understanding the term.

Carlson wants this term to mean “a single network of computers and processors that includes the ‘credit/debit card network processor.’” According to Carlson, the credit/debit card network is separate and outside of the filter, acting as a relay between the merchants/participants and the filter. This distinction is incorrect, relying on use of the terms “interfacing,” “transmitting” and “forwarding” of information to prove separateness. Carlson blurs the distinction between the credit/debit card network and its processor – in the cited uses of these terms, the language in the specifications and claims actually discusses communication between the filter processor and the network processor. The network itself is not communicating with the filter processor, as Carlson argues. From the language of the claims, it seems reasonable that all elements – from the initiating merchants to the filter processor – can be part of the existing credit/debit card network.

Additionally, Carlson wishes to add that the network does not itself generate validating or invalidating data. I do not see how adding this qualification of what a network does not do adds to the understanding of the term. Moreover, there is nothing in the specification, claim language or prosecution history that indicates this addition is necessary or appropriate.

The source of Carlson’s “single network” restriction is the patents’ use of the definite article “the.” Adding this restriction to the definition of “credit/debit card

network” does nothing to clarify the term, in part because Carlson refuses to define “network.” Carlson’s argument that we should tell the jury that a “single network” is required, but that network need not be defined invites juror confusion. If the Court were to agree with this proposal, the jury would be left to speculate about whether a given configuration of computer hardware and software constituted one network or more than one network. This is confusing and – more important – it is not a proper issue in the case, under the language of the patent. Engrafting a “single network” requirement onto the definition is not consistent with the teachings of the patents. Therefore, I will adopt Maritz’s definitions.

3. “credit/debit card network processor” (all asserted independent claims of the ‘100 and ‘695 patents)

Carlson agrees with the Maritz definition, provided that the claimed “credit/debit card network processor,” as a component of the credit/debit card network, is separate and outside the claimed filter processor or filtering method. This added qualification, however, is not appropriate in light of language in the specification that notes that the entire debit card system “may preferably be implemented as part of a pre-existing credit/debit card network.” ‘100 Pat., col. 3, ll. 54-57. Accordingly, I will not add this limitation to the definition of the claim.

4. filter, “filter processor,” and “filtering method” (used in either form in claims 1, 9, 15 and 16 of the ‘100 patent and claims 14 and 23 of the ‘695 patent)

“Filter processor” and “filtering method” are the most highly disputed claim terms. Carlson often uses the shorthand “filter” in its briefs, which Maritz correctly notes blurs the distinction between the means-plus-function, method and system claims. Maritz proposes varying definitions, depending on the referenced location and the type of claim. Maritz’s definitions are preferable.

Representative of the non-means-plus-function claims, Maritz defines a “filter processor” as used in claims 1, 9 and 15 of the ‘100 patent as:

a processor which (a) accesses the following program data: (1) data identifying the authorized unique account numbers of the participants, (2) data identifying the authorized merchants, and (3) data indicating the balance in each participant’s award account; (b) receives from the credit/debit card network processor the following transaction data: (1) the initiating account number of the card initiating the transaction, (2) merchant identification data of the initiating merchant, and (3) data regarding the amount of the initiated transaction; (c) includes means for evaluating the transaction data, and (d) includes means for transmitting validating data or invalidating data to the credit/debit card network processor.”

Remaining definitions of “filter processor” are similar in claims 16 of the ‘100 patent and claim 23 of the ‘695 patent.

Carlson seeks several limitations to the definitions involving filters. Carlson makes three arguments applicable to all claims that involve a filter processor or

filtering method. First, Carlson's "filter" is either a bank or controlled by a bank. There is some support in the specifications from which Carlson derives this notion, but such an arrangement is merely one preferred embodiment and is not required by the patent. No claim language ties the filter to a bank or to a bank's control in the claims, and there is no indication that Maritz clearly disavowed the scope of the claims.

Second, according to Carlson, the filter must be separate and outside the "credit/debit card network." Again, nothing in the claim language supports this construction, and the language in the specification contradicts the idea that the filter processor is outside of the credit/debit card network. See '100 Pat., col. 3, ll. 54-57; CMG 2653 ("crux" of the invention is "the filter process that differentiates transactions initiated by authorized and unauthorized merchants within the pre-existing network.") (emphasis supplied).

Finally, Carlson requires the filter to be solely responsible for the computations of the invention including "generating validating and invalidating" data. Carlson bases this argument on a definition of "filter program" from the Microsoft Computer Dictionary; however, this definition is unduly restrictive in the context of this patent and is unsupported by the specification.

Maritz's definitions are consistently more specific, and are tailored to the

claim at issue. Carlson's additional qualifications of the terms are neither helpful nor sufficiently supported by the intrinsic evidence. I will adopt Maritz's definitions.

5. Must the jury be told that all claims include a "filter processor"?

Carlson argues that the Court should additionally instruct the jury that a "filter" or "filter processor" is required by all claims of both patents, even if that term is not otherwise used in a claim. Carlson cites no authority for this request, and despite its attempts to explain it at the Markman hearing, I do not understand why Carlson thinks it would be appropriate for me to tell the jury that the claims require additional elements that do not appear in their language. I will not add language to the claims.

6. "validating" and "invalidating" (including validating and invalidating data) (claim 1, 15 and 16 of the '100 patent and claims 14, 15, 23 and 26 of the '695 patent)

Maritz defines "validating" as verifying or substantiating, and "invalidating" as making invalid or nullifying. Claims 14, 15 and 26 of the '695 patent use the terms "validating" and "invalidating" as verbs and in those claims the appropriate definitions are those offered by Maritz.

Claims 1, 15 and 16 of the '100 patent and claim 23 of the '695 patent use the terms "validating data" and "invalidating data." In these claims the words

“validating” and “invalidating” are adjectives modifying the noun “data.” Maritz proposes the definition that “invalidating data” is data generated by the filter processor evaluating means verifying that the initiating account number is not one of the authorized account numbers, the merchant involved in the transaction is not an authorized merchant, and/or the balance in the account corresponding to the initiating account number is insufficient to cover the amount of the initiated transaction. With a minor grammatical fix for clarification (changing “verifying” to “which verifies”) I agree that this is what the term means.

Carlson proposes that any definition of validating or invalidating, whether used as a verb or an adjective, must add the concept that all validation be within the exclusive control of a “filter.” In other words, where it is a verb, Carlson says validation/invalidation must be a function performed exclusively by a filter.

Validating/invalidating data must be data generated exclusively by a filter. Carlson says that any use of the term validating/invalidating must also say that it is the filter that causes an “approved” or “disapproved” signal to be sent to the credit/debit card network. Carlson would add this “filter” requirement even to the claims that do not use the term filter at all, and would entirely subsume other claim language into this definition. Carlson’s proposal is confusing and incorrect.

7. “input/output (I/O) port” (claims 1, 8, 15 and 16 of the ‘100 patent and claims 14, 23, and 26 of the ‘695 patent)

Maritz’s definition is again preferable and should be used in all claims.

Maritz defines “input/output” and “port” separately from the Microsoft Computer Dictionary. Carlson’s definition, taken from the preferred embodiment in the patent, is seemingly made to underscore its argument that the network is separate and outside of the filter, a notion that unduly equates physical distance of the merchants with separateness from the network. To Carlson, the “input/output port” is a feature that allows authorized or unauthorized merchants on the credit/debit card network access to that network via either an electronic or call-in (dial-up) access. There is no apparent support for the “electronic access” portion of Carlson’s definition – the cited sources in Carlson’s proposed jury instructions only discuss a call-in system. Additionally, there is nothing to show that Maritz made any clear disavowal of its asserted claim scope, as the patent includes the admonishment that the description serves as only an “illustration.” See, e.g., ‘100 Pat., col. 10 ll. 42-46; ‘695 Pat., col. 10 ll. 43-47.

8. “award account,” and “award account of the participant” (claims 1, 9, 15 and 16 of the ‘100 patent)

Carlson agrees principally with Maritz’s definitions of these terms, provided that the “account” is linked to a demand deposit account. Although the term is

discussed in the preferred embodiments, the specification also notes that the preferred embodiments are an illustration only. Carlson cites no language in the intrinsic evidence that amounts to a “clear disavowal” of a broader (non-DDA) claim scope of an account. I will thus adopt Maritz’s construction of the phrase.

9. “method” and “system” (claims 1, 15, and 16 of the ‘100 patent and claims 23 and 26 of the ‘695 patent)

Carlson agrees with Maritz’s definitions, except that it adds the requirement of transparency to the merchant. In arguing for this requirement, Carlson relies on the preamble to the independent claims and on specification language that says the transaction can be transparent to the merchant. While Carlson is correct as to the import of the preamble’s value in defining claims, the element of transparency is not required in the patent. The word “transparent” does not appear in the preambles: it only appears in the specifications and in claim 7, which is not being asserted here. Carlson argues, however, that its concept of transparency is necessarily included in the preambles because of their references to non-participating merchants being part of the network.

When the claims drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined is the one the patent protects. In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir. 1994)

(“[T]erms appearing in a preamble may be deemed limitations of a claim when they give meaning to the claim and properly define the invention.”) (internal quotation omitted); In re Stencel, 828 F.2d 751, 754 (Fed. Cir. 1987) (“Whether a preamble of intended purpose constitutes a limitation to the claim is, as has long been established, a matter to be determined on the facts of each case in view of the claimed invention as a whole.”).

The language of the preambles to these claims does not require transparency. There is insufficient language in the claims and specifications to engraft a transparency requirement onto the processing of all transactions by the invention. See ‘100 Pat., col. 5, ll. 56-67; ‘695 Pat., col. 5, ll. 56-67. Additionally, the language of dependent claims 7 of both patents would be rendered superfluous if such a construction were adopted, which should be avoided. I will therefore adopt Maritz’s definition.

10. “initiating card,” “card initiating the transaction,” and “initiating account number” (as used in some form in all asserted claims of both patents)

Maritz’s definition is rooted in the claim language. An “initiating card” is a card having an initiating account number. An “initiating account number” is an account number that is used to begin a transaction over a credit/debit card network that leads to the transmission of transaction data from the credit/debit card network

processor to the filter processor.

To Carlson, “initiating” simply means “to cause or facilitate the beginning of.” Carlson specifies that in all claims, when “initiating” is used, it is understood that the transaction is initiated before it reaches the credit/debit card network. An “initiating card” is any card that can be processed on the credit/debit card network.

Maritz’s definitions are preferable because they give life to all claim terms. If all cards of the network are “initiating cards” and result in the transmission of transaction data to the filter, much of the claim 1(c) language in the ‘100 patent would be superfluous, a result that I will avoid. I will adopt Maritz’s definitions.

C. Independent Claim 13 and Dependent Claim 14 of the ‘100 Patent

Claim 13 is a method claim with a preamble that does not mention filter, filter method or filter processor. After the general description in the preamble, it goes on to claim,

... said method comprising the steps of:

- a. providing a plurality of debit cards, each assigned to one participant and having a unique account number corresponding to an award account of the participant;
- b. accessing the following program data:
 - (1) data identifying the authorized unique account numbers of the participants,
 - (2) data identifying the authorized merchants, and

(3) data indicating the balance in each participant's award account,

said filter processor interfacing with the credit/debit card network processor;

c. transmitting the following transaction data in response to a transaction . . .

The claim goes on to include more subparagraphs, through number (h). The "said filter processor interfacing with the credit/debit card network processor" which appears at the end of subparagraph (b) is the so-called "orphan language" in dispute. The claim contains no antecedent for "said filter processor," as the term "filter processor" was not used previously.

Maritz argues that this language is a typographical error that should simply be ignored, and argues that the claim should be interpreted as if the language were not there. Carlson argues that the language is an intended part of the claim and must be defined. Maritz's expert Dr. Morley testified that one skilled in the art would have recognized this "orphan language" as a typographical or cut-and-paste error and would have ignored it, and that I should do likewise when construing the claim.

It is worth noting that claims 1, 15 and 16 of the '100 patent and claim 23 of the '695 patent contain this same language in a similar location, and the parties agree that is not a typo; each of those claims does have an appropriate antecedent

for the phrase. Conversely, claims 14 and 26 of the '695 patent, which are very similar to claim 13, do not contain the language and also do not contain any reference to a filter processor. This comparison supports Maritz's argument that the phrase was some kind of mistake.

Carlson argues that the prosecution history supports the notion that Maritz specifically amended the claims and deliberately retained the "said filter processor" language to overcome the examiner's prior art objections. During the prosecution of the patent, this clause was not deleted as an error, but instead was actually amended, to add "debit" to what was previously "credit card network processor." See CMG 2466. This amendment was done "to provide consistent terminology and antecedent basis." Id. Thus, Carlson argues that the prosecution history is inconsistent with Maritz's claim of a cut-and-paste error. The prosecution history shows, however, that this phrase was amended at the same time in all the claims where it previously appeared, so it is possible that when the amendment was made in multiple places, no one noticed that the clause should not have been in this claim at all. On the other hand, the filter processor aspect was stressed as important in distinguishing the invention from the prior art, CMG 2469, and a careful drafter should not have missed an error relating to such an important distinction.

I do not have the authority to make the corrective construction of the ‘100 patent urged by Maritz. There exists a statutory route to correct typographical errors. See 35 U.S.C. §§ 254, 255. Maritz has never taken advantage of this provision. A district court may only correct an error in a patent by interpretation when: (1) the correction is not subject to reasonable debate based on consideration of the claim language and specification, and (2) the prosecution history does not suggest a different interpretation of the claims. Novo Indust., L.P. v. Micro Molds Corp., 350 F.3d 1348, 1354 (Fed. Cir. 2003). This is not a case like Lemelson v. Gen. Mills, Inc., 968 F.2d 1202, 1203 & n. 3 (Fed.Cir. 1992), where the court added the word “toy” to the preamble of a claim because “[t]he deletion of ‘toy’ appears from the record of the proceedings before the PTO to have been an inadvertent error when the patent was printed rather than an amendment to the claim.”

Unfortunately, I find Carlson’s argument and proposed claim construction as untenable as Maritz’s suggestion that I should just ignore the language. The major problem with Carlson’s argument is that if the language is included, the claim makes no sense. The lack of antecedent for “filter processor” makes the claim impossible to construe in any meaningful way. Even aside from the lack of antecedent, the

remainder of claim 13 does not make sense if the “said filter processor” phrase is part of the claim.

I agree with Maritz that the only reasonable interpretation of events is that this was some kind of scrivener’s error. However, I cannot agree to simply ignore the language, because Maritz’s proposed correction is subject to serious debate and the prosecution history provides some support for Carlson’s argument. I therefore conclude that as a matter of law independent claim 13 and dependent claim 14 of the ‘100 patent are unenforceable as indefinite. Asking Maritz to return to the Patent and Trademark Office to correct what it concedes is an error is not asking too much, if it wishes to prospectively preserve the benefits of these claims, but it cannot seek to enforce them in this case.

Accordingly,

IT IS HEREBY ORDERED that the disputed terms, as used in the claims at issue, are construed as follows:

1. **“System,”** as used in independent claims 1, 15 and 16 of the ‘100 patent, and in independent claim 23 of the ‘625 patent is a group of elements that interact and function together as a whole.

2. **“Method,”** as used in independent claim 26 of the ‘695 patent, is a manner, means or process for implementing a program.

3. **“Credit/Debit Card Network,”** as used in independent claims 1, 15 and 16 of the ‘100 patent and independent claims 14, 23, and 26 of the ‘695 patent, is a system of one or more computers and/or processors which process, or are capable of processing, credit and debit card transactions.

4. **“Port,”** as used in independent claims 1, 15, and 16 of and dependent claim 8 of the ‘100 patent and independent claims 14, 23, and 26 of the ‘695 patent, is an interface through which data is transferred between a computer and other devices, a network, or a direct connection to another computer.

5. **“Input/Output (I/O)”** as used in independent claims 1, 15, and 16 of and dependent claim 8 of the ‘100 patent and independent claims 14, 23, and 26 of the ‘695 patent, is the complimentary tasks of gathering data for a computer or a program to work with, and making the results of the computer’s activities available to the user or to other computer processes.

6. **“Debit Cards,”** as used in independent claims 1, 15 and 16 and dependent claims 6, 7, and 8 of the ‘100 patent, are cards used to authorize, through electronic means, a reduction of an existing account balance and the transfer of payment from an account to another account, often in connection with a purchase.

7. **“Award account,”** as used in independent claims 1, 15 and 16 and dependent claim 9 of the ‘100 patent, is an account having a unique account number

associated with a debit card, reflecting the award balance.

8. **“Award Account of the Participant,”** as used in independent claims 1 and 15 of the ‘100 patent, is an account, having a unique number associated with a debit card and one of the participants, reflecting the award balance.

9. **“Filter Processor,”** as used in independent claims 1 and 15 and dependent claim 9 of the ‘100 patent, is a processor which (a) accesses the following data: (1) data identifying the authorized unique account numbers of the participants, (2) data identifying the authorized merchants, and (3) data indicating the balance in each participant’s award account; (b) receives from the credit/debit card network processor the following transaction data: (1) the initiating account number of the card initiating the transaction, (2) merchant identification data of the initiating merchant, and (3) data regarding the amount of the initiated transaction; (c) includes means for evaluating the transaction data by comparing it to the program data, and (d) includes means for transmitting validating or invalidating data to the credit/debit card network processor.

10. **“Filter Processor,”** as used in independent claim 16 of the ‘100 patent, is a processor which (a) accesses the following data: (1) data identifying the authorized unique account numbers of each card, (2) data identifying the authorized merchants, and (3) data indicating the balance in each award account; (b) receives

from the credit/debit card network processor the following transaction data: (1) the initiating account number of the card initiating the transaction, (2) merchant identification data of the initiating merchant, and (3) data regarding the amount of the initiated transaction; (c) includes means for evaluating the transaction data by comparing it to the program data, and (d) includes means for transmitting validating or invalidating data to the credit/debit card network processor.

11. **“Filter Processor,”** as used in independent claim 23 of the ‘695 patent, is a processor which (a) accesses the following data: (1) data identifying the authorized unique account numbers of the participants, (2) data identifying the authorized merchants, and (3) data indicating the balance in each participant’s account; (b) receives from the credit/debit card network processor the following transaction data: (1) the initiating account number of the card initiating the transaction, (2) merchant identification data of the merchant involved in the transaction, and (3) data regarding the amount of the initiated transaction; (c) includes means for evaluating the transaction data by comparing it to the program data, and (d) includes means for transmitting validating or invalidating data to the credit/debit card network processor.

12. **“Filtering Method,”** as used in independent claim 14 is a manner, means, or process for filtering in connection with implementing a program.

13. **“Initiating Card”** or **“Card Initiating the Transaction,”** as used in all asserted in all independent claims of the ‘100 and the ‘695 patents, is a card having an initiating account number.

14. **“Initiating Account Number,”** as used in independent claims 1, 15 and 16 of the ‘100 patent and claim 23 of the ‘695 patent, is an account number that is used to begin a transaction over a credit/debit card network that leads to the transmission of transaction data from the credit/debit card network processor to the filter processor.

15. **“Initiating Account Number,”** as used in independent claims 14 and 26 of the ‘695 patent, is an account number that is used to begin a transaction that leads to the transmission of the transaction data.

16. **“Validating data,”** as used in independent claims 1, 15, and 16 of the ‘100 patent and independent claim 23 of the ‘695 patent, is data generated by the filter processor evaluating means verifying that the transaction involves an authorized merchant using the unique account number associated with one of the cards of the program having a sufficient balance in the account to cover the transaction.

17. **“Validating,”** as used in independent claims 14 and 26 and dependent claim 15 of the ‘695 patent, means verifying or substantiating.

18. **“Invalidating data,”** as used in independent claims 1, 15 and 16 of the ‘100 patent and independent claim 23 of the ‘695 patent, is data generated by the filter processor evaluating means verifying that the initiating account number is not one of the authorized account numbers, the merchant involved in the transaction is not one of the authorized merchants, and/or the balance in the account corresponding to the initiating account number is insufficient to cover the amount of the initiated transaction.

19. **“Invalidating,”** as used in independent claims 14 and 26 and dependent claim 15 of the ‘695 patent, means making invalid or nullifying.

20. **“Credit/Debit Card Network Processor,”** as used in all asserted independent claims in the ‘100 and ‘695 patents, is the computers and/or processors of the credit/debit card network.

IT IS FURTHER ORDERED that the corresponding structures for the means-plus-function elements of the claims in dispute are those listed in the Correspondence Chart proposed by Maritz as Exhibit 3 to its post-Markman brief (docket entry # 103).

IT IS FURTHER ORDERED that independent claim 13 and dependent claim 14 of the ‘100 patent are unenforceable as a matter of law.

IT IS FURTHER ORDERED that the definitions listed as “agreed” in the

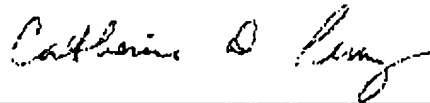
chart attached to the Supplemental Amended Statement of Claims Positions by

Carlson Companies, Inc. and Carlson marketing Group [docket entry #107], will be incorporated into the jury instructions to be used at trial. This document reflects

Carlson's agreement to Maritz's proposed definitions for the following terms:

"incentive award program" as used in independent claims 1, 15 and 16 of the '100 patent and dependent claims 25 and 28 of the '695 patent; "program" as used in independent claims 14, 23 and 26 of the '695 patent; "authorized merchants" as used in independent claims 1, 15 and 16 of the '100 patent and as used in independent claims 14, 23 and 26 of the '695 patent; "unauthorized merchants" as used in independent claims 1, 15 and 16 of the '100 patent and as used in independent claims 14, 23 and 26 of the '695 patent; "plurality of cards" as used in independent claims 14, 23 and 26 of the '695 patent; "account of the participant" as used in independent claims 14, 23 and 26 of the '695 patent; "authorized account number" as used in all asserted independent claims of the '100 patent and the '695 patent; "transmitting the following transaction data in response to a transaction, initiated by" as used in independent claims 14 and 26 of the '695 patent; "transaction" as used in all asserted independent claims of both the '100 and '695

patents; and “transaction data” as used in independent claims 1,15 and 16 of the ‘100 patent and independent claims 14, 23 and 26 of the ‘695 patent.



CATHERINE D. PERRY
UNITED STATES DISTRICT JUDGE

SO ORDERED this 3rd day of March, 2004.

Monica Mazur - Activity in Case 4:02-cv-00161-CDP Maritz, Inc., et al v. Carlson Companies, et al "Memorandum & ORDER"

From: <Moed_AutoSend@moed.uscourts.gov>
To: <MOED_ECF_Notification@moed.uscourts.gov>
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Subject: Activity in Case 4:02-cv-00161-CDP Maritz, Inc., et al v. Carlson Companies, et al "Memorandum & ORDER"

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U.S. District Court

Eastern District of Missouri (LIVE)

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Case Name: Maritz, Inc., et al v. Carlson Companies, et al
Case Number: 4:02-cv-161
Filer:
Document Number: 133

Docket Text:

MEMORANDUM AND ORDER re: General discussion of the disputed claim terms and the reasons why the Court chose such a construction as well as a specific ORDER construing these terms... IT IS HEREBY ORDERED that the disputed terms, as used in the claims at issue, are construed as follows: #1.-See Order for details. Signed by Judge Catherine D. Perry on 3/3/2004. (BDC,)

The following document(s) are associated with this transaction:

Document description:Main Document

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[STAMP dcecfStamp_ID=1037221849 [Date=3/3/2004] [FileNumber=574811-0]
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4:02-cv-161 Notice will not be electronically mailed to:

**U.S. District Court
Eastern District of Missouri (LIVE) (St. Louis)
CIVIL DOCKET FOR CASE #: 4:02-cv-00161-CDP**

Maritz, Inc., et al v. Carlson Companies, et al
Assigned to: Honorable Catherine D. Perry
Referred to:
Demand: \$0
Lead Docket: None
Related Cases: None
Case in other court: None
Cause: 35:271 Patent Infringement

Date Filed: 01/30/02
Jury Demand: Both
Nature of Suit: 830 Patent
Jurisdiction: Federal Question

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**American Express Incentive Services,
L.L.C.**

represented by **Jason M. Schwent**
(See above for address)
ATTORNEY TO BE NOTICED

Counter Claimant

Carlson Companies, Inc.

Carlson Marketing Group, Inc.

V.

Counter Defendant

**American Express Incentive Services,
L.L.C.**

represented by **Jason M. Schwent**
(See above for address)
ATTORNEY TO BE NOTICED

Maritz, Inc.

represented by **Jason M. Schwent**
 (See above for address)
ATTORNEY TO BE NOTICED

Filing Date	#	Docket Text
01/30/2002	1	COMPLAINT; # Summons Issued: 1 # Days to Respond: 20 # Counts: 2 Disclosure of Corp Cert issued to: plaintiff and defendant; jury demand exhibits attached: 1-2 (FCE) (Entered: 01/30/2002)
01/30/2002	2	RECEIPT # S2002-003585 in the amount of \$ 150 for filing fee (FCE) (Entered: 01/30/2002)
01/30/2002	3	TRACK INFORMATION STATEMENT filed by plaintiff Maritz, Inc., plaintiff American Express Inc track 2 preferred (FCE) (Entered: 01/30/2002)
01/30/2002	4	DISCLOSURE of Corporation Interests Certificate Parent companies: American Express Co Subsidiaries: none Publicly held company: American Express Co by plaintiff American Express Inc (FCE) (Entered: 01/30/2002)
01/30/2002	5	DISCLOSURE of Corporation Interests Certificate Parent companies: n/a Subsidiaries: American Express Incentive Services Publicly held company: none by plaintiff Maritz, Inc. (FCE) (Entered: 01/30/2002)
01/30/2002	6	NOTICE OF PRIVATE PROCESS SERVER ; Process Server: Metro Legal Services (FCE) (Entered: 01/30/2002)
01/30/2002		REPORT on the filing or determination of an action regarding patents (cc: form mailed to register) (FCE) (Entered: 01/30/2002)
02/06/2002	7	ALIAS SUMMONS issued as to defendant Carlson Companies ; # of summons issued: 2 # days to respond: 20 (BAK) (Entered: 02/07/2002)
02/06/2002	8	AMENDED COMPLAINT by plaintiff Maritz, Inc., plaintiff American Express Inc # Counts: 2 [1-1]; adding Carlson Marketing; jury demand (BAK) (Entered: 02/07/2002)
02/20/2002	9	RETURN OF SERVICE executed upon defendant Carlson Marketing on 2/7/02 by personal by serving Ralph Beha, Counsel Address 701 Carlson Parkway, Plymouth,MN (LSD) (Entered: 02/20/2002)
02/20/2002	10	RETURN OF SERVICE executed upon defendant Carlson Companies on 2/7/02 by personal by serving Ralph Beha Counsel;

		(LSD) (Entered: 02/20/2002)
02/25/2002	11	MOTION (included in atty appearance) by defendant Carlson Companies, defendant Carlson Marketing to extend time to answer up to and including 03/13/2002 (BDC) (Entered: 02/26/2002)
02/26/2002	11	ATTORNEY APPEARANCE for defendant Carlson Companies, defendant Carlson Marketing by John H. Quinn III, Glenn E. Davis (BDC) (Entered: 02/26/2002)
02/27/2002	<u>12</u>	RULED DOCUMENT by Honorable Catherine D. Perry granting motion to extend time to answer up to and including 03/13/2002 [11-1] EXTENTION OF TIME TO ANSWER for Carlson Companies, Carlson Marketing has been extended until 03/13/2002 (cc: all counsel) (BDC) (Entered: 02/27/2002)
03/05/2002	13	MOTION by defendant Carlson Companies, defendant Carlson Marketing for attorney Ronald J. Schutz to appear pro hac vice (BDC) Modified on 03/06/2002 (Entered: 03/06/2002)
03/05/2002	14	MOTION by defendant Carlson Companies, defendant Carlson Marketing for attorney Emmet J. McMahon to appear pro hac vice (BDC) (Entered: 03/06/2002)
03/05/2002	15	MOTION by defendant Carlson Companies, defendant Carlson Marketing for attorney Karl S. Nastrom to appear pro hac vice (BDC) (Entered: 03/06/2002)
03/06/2002	<u>16</u>	RULED DOCUMENT by Honorable Catherine D. Perry granting motion for attorney Ronald J. Schutz to appear pro hac vice [13-1] (cc: all counsel) (BDC) (Entered: 03/06/2002)
03/06/2002	<u>17</u>	RULED DOCUMENT by Honorable Catherine D. Perry granting motion for attorney Emmet J. McMahon to appear pro hac vice [14-1] (cc: all counsel) (BDC) (Entered: 03/06/2002)
03/06/2002	<u>18</u>	RULED DOCUMENT by Honorable Catherine D. Perry granting motion for attorney Karl S. Nastrom to appear pro hac vice [15-1] (cc: all counsel) (BDC) (Entered: 03/06/2002)
03/13/2002	19	ANSWER to [8-1] and COUNTERCLAIM by defendant Carlson Companies, defendant Carlson Marketing against plaintiff Maritz, Inc., plaintiff American Express Inc; jury demand (BDC) (Entered: 03/14/2002)
03/13/2002	20	DISCLOSURE of Corporation Interests Certificate: Parent companies: Carlson Companies, Inc. Subsidiaries: Deft: Carlson

		Marketing Group, Inc. is wholly owned by deft Carlson Companies, Inc. Publicly held company: None. by defendant Carlson Marketing, counter-claimant Carlson Marketing (BDC) Modified on 03/14/2002 (Entered: 03/14/2002)
03/13/2002	21	DISCLOSURE of Corporation Interests Certificate Parent companies: Not Applicable. Subsidiaries: Deft Carlson Marketing is wholly owned by deft Carlson Companies, Inc. Publicly held company: None. by defendant Carlson Companies, counter-claimant Carlson Companies (BDC) (Entered: 03/14/2002)
03/13/2002	22	TRACK INFORMATION STATEMENT filed by defendant Carlson Companies, defendant Carlson Marketing track 3(complex) preferred (BDC) (Entered: 03/14/2002)
03/15/2002	<u>23</u>	RULE 16 ORDER by Honorable Catherine D. Perry ; complex(3) track , ; Rule 16 Conference 4/19/02 ; joint scheduling plan ddl 4/12/02 (cc: all counsel) (BAK) (Entered: 03/15/2002)
04/02/2002	24	ANSWER TO COUNTERCLAIM [19-2] by counter-defendant Maritz, Inc., counter-defendant American Express Inc (BAK) (Entered: 04/03/2002)
04/11/2002	25	ATTORNEY APPEARANCE for defendant Carlson Companies, defendant Carlson Marketing, counter-claimant Carlson Companies, counter-claimant Carlson Marketing by Jeffrey H. Kass (BDC) (Entered: 04/12/2002)
04/12/2002	26	JOINT PROPOSED SCHEDULING PLAN by plaintiff, defendant, counter-claimant, counter-defendant (LSD) (Entered: 04/15/2002)
04/29/2002	<u>27</u>	CASE MANAGEMENT ORDER by Honorable Catherine D. Perry ; complex(3) track , ; motion to add party ddl 9/30/02 ; Disc completion ddl 10/1/03 ; Notice of Motion ddl set for 10/27/03 ; Motion Package ddl set for 12/8/03 ; non-disp motion ddl 10/12/03 ; jury trial 3/1/04 at 9:00 ; pt comp ddl 2/9/04 ; ADR future refer 8/1/02 , ; Any Motions to Exclude Pursuant to Daubert shall be filed by 10/27/03 , ; In-court hearing 6/19/03 at 9:00 for Markman Hearing, if parties believe that no hearing will be necessary, they are to notify the Court no later than 6/5/03 THIS ORDER CONTAINS DEADLINES FOR CLAIMS CONSTRUCTION ISSUES...SEE ORDER FOR ALL SPECIFICS(cc: all counsel) (LLW) (Entered: 04/29/2002)
05/07/2002	28	MOTION (LETTER) by defendant Carlson Companies, defendant Carlson Marketing, counter-claimant Carlson Companies, counter-claimant Carlson Marketing to amend case management order (LSD) (Entered: 05/10/2002)

05/09/2002	29	LETTER to Atty Schutz returning a COPY of a Letter sent to Hon. Catherine D. Perry regarding Case Management Schedule. Copy of local Rule 7-4.04 sent (LSD) Modified on 05/10/2002 (Entered: 05/10/2002)
05/10/2002	<u>30</u>	ORDER by Honorable Catherine D. Perry ORDERED that the clerk shall docket Mr. Schutz letter of 5/7/02 as a motion to Modify CMO. FURTHER ORDERED that the deft's Motion to Modify the CMO is granted and each side is allowed to take 25 depositions, exclusive of experts granting motion to amend case management order [28-1] (cc: all counsel) (LSD) (Entered: 05/10/2002)
05/22/2002		GENERIC SCHEDULING EVENT ; Rule 16 Conference satisfied (LJK) (Entered: 05/22/2002)
06/07/2002	31	MOTION by defendant Carlson Companies, defendant Carlson Marketing, counter-claimant Carlson Companies, counter-claimant Carlson Marketing for attorney Keiko Sugisaka to appear pro hac vice (BAK) (Entered: 06/10/2002)
06/07/2002	32	RECEIPT # 2002-007319 in the amount of \$ 25.00 for Keiko Sugisak (PHV) (BAK) (Entered: 06/10/2002)
06/13/2002	<u>33</u>	RULED DOCUMENT by Honorable Catherine D. Perry granting motion for attorney Keiko Sugisaka to appear pro hac vice [31-1] (cc: all counsel) (LSD) (Entered: 06/13/2002)
07/23/2002	<u>34</u>	STIPULATED PROTECTIVE ORDER SO ORDERED by Honorable Catherine D. Perry : See order for details (cc: all counsel) (LSD) (Entered: 07/24/2002)
08/01/2002	<u>35</u>	ORDER REFERRING CASE TO ADR: by Honorable Catherine D. Perry Case set for mediation Designation of Lead Counsel: Robert Evans ; ADR completion ddl 10/1/02 Designation of Neutral 8/21/02 ADR Conference Report ddl 10/1/02 (cc: all counsel) (BAK) (Entered: 08/01/2002)
08/15/2002	36	JOINT MOTION by plaintiffs and defendants to modify/amend the Court's 08/01/2002 Order referring this Case to Alternative Dispute Resolution up to and including 12/20/2002 (in order to allow the parties additional time to conduct discovery) (BDC) (Entered: 08/16/2002)
08/16/2002	<u>37</u>	RULED DOCUMENT by Mag Judge Thomas C. Mummert granting motion to modify/amend the Court's 08/01/2002 Order referring this Case to Alternative Dispute Resolution up to and including 12/20/2002 (in order to allow the parties additional time to conduct

		discovery) [36-1] ; ADR completion ddl 12/20/02 , (cc: all counsel) (LSD) (Entered: 08/19/2002)
09/03/2002	38	MOTION by plaintiff, defendant, counter-claimant, counter-defendant to extend ADR deadlines (LSD) (Entered: 09/04/2002)
09/04/2002	<u>39</u>	RULED DOCUMENT by Honorable Catherine D. Perry granting motion to extend ADR deadlines [38-1] Designation of Neutral 9/16/02 ADR Conference Report ddl 9/16/02 (cc: all counsel) (LSD) (Entered: 09/04/2002)
09/16/2002	40	DESIGNATION NEUTRAL REPORT by plaintiff Maritz, Inc., plaintiff American Express Inc, defendant Carlson Companies, defendant Carlson Marketing, counter-claimant Carlson Companies, counter-claimant Carlson Marketing, counter-defendant Maritz, Inc., counter-defendant American Express Inc Neutral: Richard Sher date of conference: 12/16/02 time: 9:00 location: Office of Richard Sher (BAK) (Entered: 09/18/2002)
09/18/2002	<u>41</u>	NOTICE of appointment of neutral; neutral: Richard P. Sher; neutral selected by: parties (BAK) (Entered: 09/18/2002)
09/30/2002	42	MOTION w/memo in sppt by plaintiff Maritz, Inc., plaintiff American Express Inc for leave to file second amended complaint (Proposed original 2nd amended complaint w/exhibits 1&2 attached (LSD) (Entered: 10/01/2002)
10/02/2002		GENERIC SCHEDULING EVENT ; Motion to Add Party ddl satisfied (LSD) (Entered: 10/02/2002)
10/21/2002	<u>43</u>	RULED DOCUMENT by Honorable Catherine D. Perry granting motion for leave to file second amended complaint [42-1] GRANTED, CDP, 10/21/2002. (cc: all counsel) (BDC) (Entered: 10/21/2002)
10/21/2002	44	SECOND AMENDED COMPLAINT by plaintiff Maritz, Inc., plaintiff American Express Inc [8-1], [1-1]against Defts: Carlson Companies, Inc., Carlson MARKeting Group, Inc., and adding deft: Wildcard Systems Inc (BDC) (Entered: 10/21/2002)
10/24/2002	45	NOTICE OF PRIVATE PROCESS SERVER ; Process Server: Wendel Process Servers (BAK) (Entered: 10/28/2002)
10/24/2002	46	ALIAS SUMMONS issued as to defendant Wildcard Systems Inc ; # of summons issued: 1 # days to respond: 20 (BAK) (Entered: 10/28/2002)

11/07/2002	47	ANSWER to SECOND AMENDED COMPLAINT [44-1] and COUNTERCLAIM by defendant Carlson Companies, defendant Carlson Marketing against plaintiff Maritz, Inc., plaintiff American Express Inc; jury demand (LSD) (Entered: 11/07/2002)
11/19/2002	48	ATTORNEY APPEARANCE for defendant WildCard Systems by Helmut M. Starr, Bryan D. LeMoine (LSD) (Entered: 11/19/2002)
11/19/2002	49	MOTION by defendant WildCard Systems to amend the case management order to extend deadlines 4 mos. , and to extend time to answer to & including 12/2/02 (LSD) (Entered: 11/19/2002)
11/19/2002	50	MOTION by defendant WildCard Systems to amend the Case Management Order (LSD) (Entered: 11/19/2002)
11/20/2002	<u>51</u>	RULED DOCUMENT by Honorable Catherine D. Perry granting motion to amend the case management order to extend deadlines 4 mos. [49-1], granting motion to extend time to answer to & including 12/2/02 [49-2] (cc: all counsel) (BAK) (Entered: 11/20/2002)
11/20/2002	<u>52</u>	RULED DOCUMENT by Honorable Catherine D. Perry granting motion to amend the Case Management Order [50-1]all provisions of CMO not modified remain in effect.Wilcard shall make all disclosures 26(a)(1) by 12/22/02. filing of joint statement of claims disputes 7/3/03. Disclosure of expert on claims construction...7/17/03 Rebuttal 8/7/03 Experts available for deposition 9/17/03. MARKMAN BRIEF 9/17/03 Responsive brief 10/3/03. Prposed jury instructions 10/3/03 MARKMAN Hearing Thursday 10/23/03 parties to notify court by 10/3/03 if hearing is not necessary. ... all discovery completed by 2/2/04... ADR referral 2/1/02 to terminate 4/4/03... Motions to exclude pursuant to Daubert v. Merrel Dow no later than 2/27/04 (See order for details) ; Disc completion ddl 2/4/04 ; Notice of Motion ddl set for 2/27/04 , ; Motion Package ddl set for 4/8/04 , ; jury trial 7/5/04 9:00 THIS IS A TWO WEEK DOCKET ; pt comp ddl 6/20/04 ; final pre-trial conference 7/5/04 8:30 , ; Daubert Pretrial Compl 2/27/04 (cc: all counsel) (LSD) Modified on 11/21/2002 (Entered: 11/20/2002)
12/02/2002	53	ANSWER to [44-1] and COUNTERCLAIM by defendant WildCard Systems against plaintiff Maritz, Inc., plaintiff American Express Inc; jury demand (LSD) (Entered: 12/02/2002)
12/13/2002	54	MOTION by plaintiffs for leave of COurt to allow the pltfs to file a reply to the Carlson Defts' Counterclaim filed with the attached proposed Reply to Counterclaim. (BDC) (Entered: 12/14/2002)
12/16/2002	<u>55</u>	RULED DOCUMENT by Honorable Catherine D. Perry granting motion for leave of COurt to allow the pltfs to file a reply to the

		Carlson Defts' Counterclaim [54-1] (cc: all counsel) (LSD) (Entered: 12/16/2002)
12/16/2002	56	ANSWER TO COUNTERCLAIM [47-2] by counter-defendant Maritz, Inc., counter-defendant American Express Inc (LSD) (Entered: 12/16/2002)
12/18/2002	57	RECEIPT # S2003-002557 in the amount of \$ 25.00 for atty adm. fee-pro hac vice for Andrea L. Gothing. (BDC) (Entered: 12/19/2002)
12/18/2002	58	MOTION by defendant Carlson Companies, defendant Carlson Marketing, counter-claimant Carlson Companies, counter-claimant Carlson Marketing, counter-claimant Carlson Companies, counter-claimant Carlson Marketing for attorney ANDREA L. GOTHING to appear pro hac vice (BDC) (Entered: 12/19/2002)
12/20/2002	<u>59</u>	RULED DOCUMENT by Honorable Catherine D. Perry granting motion for attorney ANDREA L. GOTHING to appear pro hac vice [58-1] and represent Carlson Co., Inc. and Carlson Marketing Group, Inc. GRANTED, CDP, 12/20/2002. (cc: all counsel) (BDC) (Entered: 12/20/2002)
12/26/2002	60	ANSWER TO COUNTERCLAIM [53-2] by counter-defendant Maritz, Inc., counter-defendant American Express Inc (BDC) (Entered: 12/26/2002)
02/13/2003	<u>61</u>	PROTECTIVE ORDER by Honorable Catherine D. Perry (Stipulated Amendment to Protective order) (See order for details) : re [34-1] (cc: all counsel) (LSD) (Entered: 02/13/2003)
04/04/2003	62	ADR COMPLIANCE REPORT An ADR conference was held on 4/1/2003; Neutral: Richard P. Sher; The parties DID NOT achieve a settlement. (BDC) (Entered: 04/07/2003)
06/13/2003	63	MOTION by plaintiffs to compel prior art on or before 7/7/2003 , and to modify/amend case deadlines related to claim construction . (BDC) (Entered: 06/16/2003)
06/13/2003	64	MOTION by plaintiffs to compel Carlson Defendants to provide discovery relating to their affirmative defenses and intent to trly on an opion of counsel . (BDC) (Entered: 06/16/2003)
06/20/2003	65	MOTION by Carlson Marketing for attorney Gunnar Wieboldt to appear pro hac vice (LSD) (Entered: 06/23/2003)
06/20/2003	66	RECEIPT # s2003-008423 in the amount of \$ 25.00 for PHV fee (LSD) (Entered: 06/23/2003)

06/23/2003	<u>67</u>	RULED DOCUMENT by Honorable Catherine D. Perry granting motion for attorney Gunnar Wieboldt to appear pro hac vice [65-1] for Carlson Cos and Carlson Marketing (cc: all counsel) (LSD) (Entered: 06/23/2003)
06/24/2003	68	MOTION by defendant Carlson Companies, defendant Carlson Marketing, counter-claimant Carlson Companies, counter-claimant Carlson Marketing, counter-claimant Carlson Companies, counter-claimant Carlson Marketing to bifurcate willfulness from liability and actual damages for purposes of trial and discovery Memorandum in support attached (BAK) (Entered: 06/25/2003)
06/24/2003	69	RESPONSE by defendant Carlson Companies, defendant Carlson Marketing, counter-claimant Carlson Companies, counter-claimant Carlson Marketing, counter-claimant Carlson Companies, counter-claimant Carlson Marketing to motion to compel prior art on or before 7/7/2003 [63-1], to motion to modify/amend case deadlines related to claim construction [63-2] (BAK) (Entered: 06/25/2003)
06/24/2003	70	REPLY by plaintiff Maritz, Inc., counter-defendant Maritz, Inc., counter-defendant Maritz, Inc., counter-defendant Maritz, Inc. to response to motion to compel prior art on or before 7/7/2003 [63-1], motion to modify/amend case deadlines related to claim construction [63-2] (BAK) (Entered: 06/25/2003)
06/24/2003	71	RESPONSE by defendant Carlson Companies, defendant Carlson Marketing, counter-claimant Carlson Companies, counter-claimant Carlson Marketing, counter-claimant Carlson Companies, counter-claimant Carlson Marketing to motion to compel Carlson Defendants to provide discovery relating to their affirmative defenses and intent to trly on an opion of counsel [64-1] (BAK) (Entered: 06/25/2003)
06/26/2003	72	REPLY by plaintiff Maritz, Inc., plaintiff American Express Inc, counter-defendant Maritz, Inc., counter-defendant American Express Inc, counter-defendant Maritz, Inc., counter-defendant American Express Inc, counter-defendant Maritz, Inc., counter-defendant American Express Inc to response to motion to compel Carlson Defendants to provide discovery relating to their affirmative defenses and intent to trly on an opion of counsel [64-1] (BAK) (Entered: 06/27/2003)
06/26/2003	72	RESPONSE by plaintiff Maritz, Inc., plaintiff American Express Inc, counter-defendant Maritz, Inc., counter-defendant American Express Inc, counter-defendant Maritz, Inc., counter-defendant American Express Inc, counter-defendant Maritz, Inc., counter-defendant American Express Inc to motion to bifurcate willfulness from liability and actual damages for purposes of trial and discovery [68-1] (BAK) (Entered: 06/27/2003)

07/01/2003	<u>73</u>	REQUEST by plaintiff, defendant, counter-claimant, counter-defendant, defendant, counter-claimant, counter-defendant, counter-claimant, counter-defendant for modification of deadlines relating to claim interpretation (BAK) (Entered: 07/02/2003)
07/02/2003	<u>74</u>	ORDER by Honorable Catherine D. Perry granting request [73-1], denying as moot motion to compel prior art on or before 7/7/2003 [63-1], granting motion to modify/amend case deadlines related to claim construction [63-2] (cc: all counsel) (BAK) (Entered: 07/02/2003)
07/07/2003	75	REPLY by defendant Carlson Companies, defendant Carlson Marketing to pltf's response to defts' motion to bifurcate willfulness from liability and actual damages for purposes of trial and discovery [68-1] (BDC) (Entered: 07/08/2003)
07/16/2003	<u>76</u>	ORDER by Honorable Catherine D. Perry IT IS HEREBY ORDERED that deft's motion to bifurcate is denied [68-1] FURTHER ORDERED that deft's motion to compel is granted in part and denied in part (see order for details) [64-1] (cc: all counsel) (LSD) (Entered: 07/16/2003)
07/17/2003	78	MOTION by counter-defendant American Express Inc, counter-defendant Maritz, Inc., counter-claimant WildCard Systems, counter-defendant American Express Inc, counter-defendant Maritz, Inc., counter-claimant Carlson Marketing, counter-claimant Carlson Companies, defendant WildCard Systems, counter-defendant American Express Inc, counter-defendant Maritz, Inc., counter-claimant Carlson Marketing, counter-claimant Carlson Companies, defendant Carlson Marketing, defendant Carlson Companies, plaintiff American Express Inc, plaintiff Maritz, Inc. to extend time up to and including 7/21/03 to file Joint Statement of Claims Disputes (BAK) (Entered: 07/21/2003)
07/18/2003	<u>77</u>	ORDER by Honorable Catherine D. Perry IT IS HEREBY ORDERED that the parties' joint request for additional time is granted. The parties' joint statement of claims disputes shall now be due on or before 7/21/03(cc: all counsel) (BAK) (Entered: 07/18/2003)
07/21/2003	79	JOINT STATEMENT OF CLAIM DISPUTES by counter-defendant, counter-claimant, counter-defendant, counter-claimant, defendant, counter-defendant, counter-claimant, defendant, plaintiff (BDC) (Entered: 07/22/2003)
09/17/2003	80	MOTION by defendant Carlson Marketing, defendant Carlson Companies for leave to file briefs in excess of 15-page limit (BDC) (Entered: 09/18/2003)

09/17/2003	81	SEALED OPENING CLAIM CONSTRUCTION BRIEF submitted by defendant Carlson Marketing, defendant Carlson Companies (BDC) (Entered: 09/18/2003)
09/17/2003	81	SEALED DOCUMENT by defendant Carlson Marketing, defendant Carlson Companies [81-1] (BDC) (Entered: 09/18/2003)
09/17/2003	82	CLAIM CONSTRUCTION BRIEF submitted by plaintiff American Express Inc, plaintiff Maritz, Inc. (BDC) (Entered: 09/18/2003)
09/18/2003		Text not available. (Entered: 09/18/2003)
09/18/2003	<u>83</u>	ORDER by Honorable Catherine D. Perry granting motion of the depts' for leave to file briefs in excess of 15-page limit [80-1] THE PARTIES OPENING MARKMAN BRIEFS SHALL BE NO LONGER THAN 25 PAGES IN LENGTH.(cc: all counsel) (BDC) (Entered: 09/18/2003)
09/24/2003	84	RECEIPT # S2003-011350 in the amount of \$ 25.00 for atty pro hac vice fee for Rita Coyle DeMeules. (BDC) (Entered: 09/25/2003)
09/24/2003	85	MOTION by counter-claimant Carlson Marketing, counter-claimant Carlson Companies, counter-claimant Carlson Marketing, counter-claimant Carlson Companies, defendant Carlson Marketing, defendant Carlson Companies for attorney Rita Coyle DeMeules to appear pro hac vice (BDC) (Entered: 09/25/2003)
09/25/2003	<u>86</u>	ORDER by Honorable Catherine D. Perry granting motion for attorney Rita Coyle DeMeules to appear pro hac vice [85-1] (cc: all counsel) (LSD) (Entered: 09/26/2003)
09/30/2003	87	MOTION by Carlson Marketing, Carlson Companies to extend due date for claim construction reply briefs and proposed jury instructions (LSD) (Entered: 09/30/2003)
10/01/2003	<u>88</u>	ORDER by Honorable Catherine D. Perry granting motion to extend due date for claim construction reply briefs and proposed jury instructions [87-1] up to and including 10/7/03. THE PARTIES MUST DELIVER A COURTESTY COPY TO CHAMBERS BY NOON ON 10/7 AND NO EXTENSIONS WILL BE ALLOWED (CDP)(cc: all counsel) (BAK) (Entered: 10/01/2003)
10/07/2003	89	MOTION by plaintiff American Express Inc, plaintiff Maritz, Inc. for leave to exceed page limit by filing brief not exceeding 25pp in response to Carlson's claim construction brief (LSD) (Entered: 10/07/2003)

10/07/2003	90	MOTION by plaintiff American Express Inc, plaintiff Maritz, Inc. for leave to file exhibit 7 to pltf's response to Carlson's claim construction brief under seal (LSD) (Entered: 10/07/2003)
10/07/2003	91	PROPOSED JURY INSTRUCTIONS on claim construction submitted by plaintiff American Express Inc, plaintiff Maritz, Inc. (LSD) (Entered: 10/07/2003)
10/07/2003	92	MOTION by plaintiff American Express Inc, plaintiff Maritz, Inc. to strike defts' submission of interpretations for certain claim terms , or in the alternative for leave to supplement claim construction briefing on terms "transaction" and "transaction data" (LSD) (Entered: 10/07/2003)
10/07/2003	93	REPLY BRIEF to Plaintiff's opening brief for claim construction w/ exhibits M, N, O & P submitted by defendant Carlson Marketing, defendant Carlson Companies (LSD) Modified on 10/08/2003 (Entered: 10/08/2003)
10/07/2003	94	PROPOSED JURY INSTRUCTIONS regarding patent claim terms submitted by defendant (LSD) (Entered: 10/08/2003)
10/09/2003	95	ORDER by Honorable Catherine D. Perry granting motion for leave to file exhibit 7 to pltf's response to Carlson's claim construction brief under seal [90-1], granting motion for leave to exceed page limit by filing brief not exceeding 25pp in response to Carlson's claim construction brief [89-1] (cc: all counsel) (LSD) (Entered: 10/09/2003)
10/09/2003	96	RESPONSE to claim construction brief with exhibits 1-10 exhibit 7 filed under seal by plaintiff American Express Inc, plaintiff Maritz, Inc. to [93-1] (LSD) (Entered: 10/09/2003)
10/14/2003	<u>97</u>	MOTION for Leave to Supplement Plaintiffs' Response to Carlson's Claim Construction Brief by Plaintiffs American Express Incentive Services, L.L.C., Maritz, Inc.. (Schwent, Jason) (Entered: 10/14/2003)
10/14/2003	<u>98</u>	PROPOSED SUPPLEMENTAL CONSTRUCTIONS [93] Trial Brief by Plaintiffs American Express Incentive Services, L.L.C., Maritz, Inc.. (Schwent, Jason) Modified on 10/16/2003 (LSD,). (Entered: 10/14/2003)
10/14/2003	<u>99</u>	PROPOSED SUPPLEMENTAL JURY INSTRUCTIONS [91] Jury Instructions by Plaintiffs American Express Incentive Services, L.L.C., Maritz, Inc.. (Schwent, Jason) Modified on 10/16/2003 (LSD,). (Entered: 10/14/2003)

10/14/2003	<u>100</u>	RESPONSE in Opposition re [92] Motion to StrikeMotion for Leave toMotion for Leave to <i>OPPOSITION TO PLAINTIFF'S MOTION TO STRIKE DEFENDANTS' CONSTRUCTION OF "TRANSACTION" AND "TRANSACTION DATA"</i> filed by Defendants Carlson Companies, Inc., Carlson Marketing Group, Inc.. (Quinn, John) (Entered: 10/14/2003)
10/23/2003	<u>102</u>	Minute Entry for proceedings held before Judge Catherine D Perry : Markman Hearing held on 10/23/2003. (Court Reporter or FTR Gold Operator initials:Teri Hopwood.) (FTR Gold yes or no: no.) (BAK,) Modified on 10/24/2003 (BAK,). - Note: Attorney Helmut Starr was present for Markman hearing but was left off minute sheet. (Entered: 10/24/2003)
10/24/2003	<u>101</u>	AMENDED CASE MANAGEMENT ORDERORDERED that the CMO previously entered in this case is modified in the following repects: Amended statement of claims positions shall be filed 10/31/03; Expert witnesses on issues other than claims construction: expert witness disclosures/reports shall be made not later than 12/22/03, rebuttal 1/23/04, experts made available for depos. 2/17/04. all disocvery completed2/17/03 Dispositive Motions due by 2/27/2004. Oppositions due 3/29/04 and reply due 4/8/04. Jury Trial set for 7/5/2004 09:00 AM in Courtroom 14S before Honorable Catherine D Perry. Pretrial Conference set for 7/5/2004 08:30 AM in Courtroom 14S before Honorable Catherine D Perry.. Signed by Judge Catherine D Perry on 10/24/03. (LSD,) (Entered: 10/24/2003)
10/31/2003	<u>103</u>	MARKMAN BRIEF by Plaintiffs American Express Incentive Services, L.L.C., Maritz, Inc. <i>POST-MARKMAN HEARING SUBMISSION: STATEMENT OF CLAIMS POSITIONS.</i> (Attachments: # <u>1</u> Exhibit 1# <u>2</u> Exhibit 2# <u>3</u> Exhibit 3# <u>4</u> Exhibit 4# <u>5</u> Exhibit 5)(Schwent, Jason) (Entered: 10/31/2003)
10/31/2003	<u>104</u>	AMENDED DOCUMENT by Defendants Carlson Companies, Inc., Carlson Marketing Group, Inc.. Amendment to <u>101</u> Case Management Order - Amended,, <i>AMENDED STATEMENT OF CLAIMS POSITIONS BY CARLSON COMPANIES, INC. AND CARLSON MARKETING GROUP.</i> (Attachments: # <u>1</u>)(Quinn, John) (Entered: 10/31/2003)
11/04/2003	<u>105</u>	MOTION for Leave to FILE SUPPLEMENTAL AMENDED STATEMENT OF CLAIMS POSITIONS by Defendants Carlson Companies, Inc., Carlson Marketing Group, Inc.. (Attachments: # <u>1</u> Exhibit)(Quinn, John) (Entered: 11/04/2003)
11/04/2003	<u>106</u>	RESPONSE to Motion re <u>105</u> MOTION for Leave to FILE SUPPLEMENTAL AMENDED STATEMENT OF CLAIMS POSITIONS filed by Plaintiffs American Express Incentive Services,

		L.L.C., Maritz, Inc.. (Schwent, Jason) (Entered: 11/04/2003)
11/05/2003		Docket Text ORDER re <u>105</u> MOTION for Leave to FILE SUPPLEMENTAL AMENDED STATEMENT OF CLAIMS POSITIONS filed by Carlson Marketing Group, Inc., Carlson Companies, Inc. ; ORDERED granted. Signed by Judge Catherine D. Perry on 11/05/03. (CDP,) (Entered: 11/05/2003)
11/05/2003	<u>107</u>	SUPPLEMENTAL AMENDED STATEMENT OF CLAIMS POSITIONS by Carlson Companies, Inc., Carlson Marketing Group, Inc. (leave to file granted 11/5/03 DETACHED FROM MOTION #105 AND FILED) (LSD,) Modified on 11/6/2003 (LSD,NOTICE MAILED TO NON-REGISTERED ATTYS). (Entered: 11/06/2003)
12/09/2003	<u>108</u>	MOTION to Withdraw as Attorney <i>DEFENDANT CARLSON'S MOTION TO WITHDRAW CERTAIN INIDIVIDUAL COUNSEL</i> ;attorney/firm Karl Nastrom and Keiko Sugisaka by Defendants Carlson Companies, Inc., Carlson Marketing Group, Inc.. (Quinn, John) (Entered: 12/09/2003)
12/10/2003		Docket Text ORDER re <u>108</u> MOTION to Withdraw as Attorney <i>DEFENDANT CARLSON'S MOTION TO WITHDRAW CERTAIN INIDIVIDUAL COUNSEL</i> ;attorney/firm Karl Nastrom and Keiko Sugisaka filed by Carlson Marketing Group, Inc., Carlson Companies, Inc. ; ORDERED GRANTED. Signed by Judge Catherine D. Perry on 12/10/03. (CDP,) Modified on 12/10/2003 (LSD,COPY OF ELECTRONIC NOTIFICATION SHEET MAILED TO ATTYS KEIKO SUGISAKA AND KARL NASTROM). (Entered: 12/10/2003)
12/15/2003	<u>109</u>	NOTICE by Defendants Carlson Companies, Inc., Carlson Marketing Group, Inc. <i>NOTICE OF FILING DOCUMENT UNDER SEAL</i> (Quinn, John) (Entered: 12/15/2003)
12/15/2003	<u>110</u>	MOTION for Leave to FILE FIRST AMENDED ANSWER AND COUNTERCLAIM by Defendants Carlson Companies, Inc., Carlson Marketing Group, Inc.. (Quinn, John) (Entered: 12/15/2003)
12/15/2003	<u>111</u>	SEALED MEMORANDUM w/exhibits A-0 attached in Support of re <u>110</u> MOTION for Leave to FILE FIRST AMENDED ANSWER AND COUNTERCLAIM filed by Defendants Carlson Companies, Inc., Carlson Marketing Group, Inc., Counter Claimants Carlson Companies, Inc., Carlson Companies, Inc., Carlson Marketing Group, Inc.,Carlson Marketing Group,Inc. (LSD,) (Entered: 12/16/2003)
12/19/2003	<u>112</u>	MOTION for Leave to file first amended answer and counterclaim by Defendant WildCard Systems Incorporated. (Starr, Helmut) (Entered: 12/19/2003)

12/19/2003	<u>113</u>	NOTICE by Defendant WildCard Systems Incorporated filing document under seal: (Starr, Helmut) (Entered: 12/19/2003)
12/22/2003	114	SEALED MOTION for Leave to file MOTION FOR LEAVE TO FILE FIRST AMENDED ANSWER AND COUNTERCLAIM AND MEMORANDUM IN SUPPORT, UNDER SEAL SEE ALSO - NOTICE OF FILING PLEADGINS UNDER SEAL AND IN PAPER FORMAT, DOC.#113 filed by Defendant WildCard Systems Incorporated. (BDC,) Modified on 12/23/2003-**WITH ATTACHED PROPOSED SEALED DOCUMENT (BDC,). (Entered: 12/23/2003)
12/24/2003	<u>115</u>	MOTION for Extension of Time to File Response/Reply by Plaintiff American Express Incentive Services, L.L.C.. (Harlan, David) (Entered: 12/24/2003)
12/29/2003		Docket Text ORDER re <u>115</u> MOTION for Extension of Time to File Response/Reply filed by American Express Incentive Services, L.L.C. ; ORDERED GRANTED, response now due 12/30/03. Signed by Judge Catherine D. Perry on 12/29/03. (CDP,) (Entered: 12/29/2003)
12/30/2003	<u>116</u>	NOTICE by Plaintiffs American Express Incentive Services, L.L.C., Maritz, Inc. Filing Under Seal Opposition to Defendants' Motion Seeking Leave to Amend Answer: (Schwent, Jason) (Entered: 12/30/2003)
12/30/2003	117	SEALED RESPONSE/Memorandum in Opposition re [114] MOTION for Leave to file under seal, <u>110</u> MOTION for Leave to FILE FIRST AMENDED ANSWER AND COUNTERCLAIM, <u>112</u> MOTION for Leave to file first amended answer and counterclaim filed by Plaintiffs American Express Incentive Services, L.L.C., Maritz, Inc. (FILED IN PAPER FORMAT AS DOCUMENT IS UNDER SEAL) (LSD,) (Entered: 12/31/2003)
01/07/2004	<u>118</u>	NOTICE by Defendants Carlson Companies, Inc., Carlson Marketing Group, Inc. <i>NOTICE OF FILING DOCUMENT UNDER SEAL: DEFENDANTS' REPLY BRIEF IN FURTHER SUPPORT OF DEFENDANTS' MOTION FOR LEAVE TO FILE FIRST AMENDED ANSWER AND COUNTERCLAIM:</i> (Quinn, John) (Entered: 01/07/2004)
01/08/2004	119	SEALED BRIEF IN FURTHER SUPPORT OF DEFENDANT'S MOTION FOR LEAVE TO FILE AN AMENDED ANSWER AND COUNTERCLAIM/REPLY to Response to Motion re <u>110</u> MOTION for Leave to FILE FIRST AMENDED ANSWER AND COUNTERCLAIM filed by Defendants Carlson Companies, Inc., Carlson Marketing Group, Inc.. (BDC,) (Entered: 01/09/2004)

01/12/2004	<u>120</u>	ORDER granting <u>112</u> Motion for Leave to file amended answer and counterclaim [114] Signed by Judge Catherine D. Perry on 1/12/04. (LSD,) (Entered: 01/12/2004)
01/13/2004	<u>121</u>	ANSWER to Amended Complaint, COUNTERCLAIM against plaintiff all plaintiffs by WildCard Systems Incorporated (LSD,) (Entered: 01/13/2004)
01/13/2004	<u>122</u>	MOTION to Modify <u>101</u> Case Management Order - Amended,, by Plaintiffs American Express Incentive Services, L.L.C., Maritz, Inc., Counter Defendants American Express Incentive Services, L.L.C., American Express Incentive Services, L.L.C., American Express Incentive Services, L.L.C., American Express Incentive Services, L.L.C., Maritz, Inc., Maritz, Inc., Maritz, Inc., Maritz, Inc., Defendants Carlson Marketing Group, Inc., WildCard Systems Incorporated, Counter Claimants Carlson Marketing Group, Inc., Carlson Marketing Group, Inc., WildCard Systems Incorporated, WildCard Systems Incorporated. (BAK,) (Entered: 01/13/2004)
01/14/2004	<u>123</u>	THIRD AMENDED CASE MANAGEMENT ORDER re: <u>122</u> MOTION to Amend/Correct <u>101</u> Case Management Order. Discovery Completion due by 5/7/2004. Non-Dispositive Motions due by 5/18/2004. Dispositive Motions due by 5/28/2004. Jury Trial set for 10/18/2004 09:00 AM in Courtroom 14S before Honorable Catherine D. Perry. FURTHER ORDERED that any party wishing to change any of the deadlines set forth in this order must file a motion to do so no later than 2/2/04. (see order for details) Signed by Judge Catherine D. Perry on 1/14/04. (LSD,) (Entered: 01/14/2004)
01/20/2004	<u>124</u>	ORDER granting <u>110</u> Motion for Leave to file amended answer and counterclaim Signed by Judge Catherine D. Perry on 1/20/04. (BAK,) (Entered: 01/20/2004)
01/20/2004	<u>125</u>	FIRST AMENDED ANSWER to Second Amended Complaint, COUNTERCLAIM against plaintiff American Express Incentive Services, L.L.C., Maritz, Inc. by Carlson Companies, Inc., Carlson Marketing Group, Inc.(LSD,) (Entered: 01/21/2004)
01/26/2004	<u>126</u>	ANSWER TO CLAIM and REPLY TO AFFIRMATIVE DEFENSES re <u>121</u> Answer to Amended Complaint, Counterclaim by Plaintiffs American Express Incentive Services, L.L.C., Maritz, Inc., American Express Incentive Services, L.L.C., Maritz, Inc. by Plaintiffs American Express Incentive Services, L.L.C., Maritz, Inc., American Express Incentive Services, L.L.C., Maritz, Inc.. (Schwent, Jason) (Entered: 01/26/2004)
01/29/2004	<u>127</u>	Joint MOTION to Amend/Correct <u>123</u> Case Management Order - Amended,, by Plaintiffs American Express Incentive Services,

		L.L.C., Maritz, Inc.. (Schwent, Jason) (Entered: 01/29/2004)
01/29/2004	<u>128</u>	MOTION for Leave to File First Amended Reply to WildCard's First Amended Counterclaim by Plaintiffs American Express Incentive Services, L.L.C., Maritz, Inc.. (Attachments: # <u>1</u> Attachment) (Schwent, Jason) (Entered: 01/29/2004)
01/30/2004	<u>129</u>	AMENDED CASE MANAGEMENT ORDER <u>127</u> Joint MOTION to Amend/Correct <u>123</u> Case Management Order - Amended,, filed by Maritz, Inc., American Express Incentive Services, L.L.C., <u>128</u> MOTION for Leave to File First Amended Reply to WildCard's First Amended Counterclaim filed by Maritz, Inc., American Express Incentive Services, L.L.C. motion are GRANTED. Dispositive Motions due by 6/9/2004. Jury Trial reset for 10/25/2004 09:00 AM in Courtroom 14S before Honorable Catherine D. Perry. (see order for further details). Signed by Judge Catherine D. Perry on 1/30/04. (BAK,) (Entered: 01/30/2004)
01/30/2004	<u>130</u>	AMENDED ANSWER TO CLAIM and REPLY TO AFFIRMATIVE DEFENSES re <u>126</u> Answer to Claim and Reply to Affirmative Defenses,, <u>121</u> Answer to Amended Complaint, Counterclaim by American Express Incentive Services, L.L.C., Maritz, Inc., (Leave to file granted in Amended Case Management Order #129 filed this date)(BAK,) (Entered: 01/30/2004)
02/02/2004	<u>131</u>	ANSWER TO CLAIM and REPLY TO AFFIRMATIVE DEFENSES of <i>Carlson Defendants</i> by Plaintiffs American Express Incentive Services, L.L.C., Maritz, Inc., Counter Defendants American Express Incentive Services, L.L.C., Maritz, Inc. by Plaintiffs American Express Incentive Services, L.L.C., Maritz, Inc., Counter Defendants American Express Incentive Services, L.L.C., Maritz, Inc.. (Schwent, Jason) (Entered: 02/02/2004)
03/03/2004	<u>132</u>	AMENDED CASE MANAGEMENT ORDER (see Order for details). Signed by Judge Catherine D. Perry on 3/3/04. (BAK,) (Entered: 03/03/2004)
03/03/2004	<u>133</u>	MEMORANDUM AND ORDER re: General discussion of the disputed claim terms and the reasons why the Court chose such a construction as well as a specific ORDER construing these terms... IT IS HEREBY ORDERED that the disputed terms, as used in the claims at issue, are construed as follows: #1.-See Order for details. Signed by Judge Catherine D. Perry on 3/3/2004. (BDC,) (Entered: 03/03/2004)
03/24/2004	<u>134</u>	ENTRY of Appearance by Michael D. Okerlund Defendants Carlson Companies, Inc., Carlson Marketing Group, Inc.. (Okerlund, Michael) (Entered: 03/24/2004)

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